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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1935.

No. 31.

G. S. ROGERS, doing business as **REX DUPLEX FITTING COMPANY**, and **R. W. DUSENBERRY**,
Defendant-Petitioners.

vs.

ALEMITE CORPORATION,
Plaintiff-Respondent.

BRIEF ON BEHALF OF PLAINTIFF-RESPONDENT.

I.

The Petitioners Now Tacitly Concede the Correctness of the Decisions of the Lower Courts Upon the Only Question Which Was in Issue Before Them, But They Now Invite This Court to Consider and Decide Some New Issues Which Were Never Pleaded, Never Argued or Decided in the Lower Courts, and Never Made the Subject of the Petition for Writ of Certiorari.

Ever since the Gullborg patent No. 1,307,734 in suit (R., p. 259) was issued on June 24, 1919, the plaintiff-respondent has been engaged in the manufacture and

sale of the so-called "Alemite" lubricating system in a form substantially identical with that illustrated and described in the patent.

In accordance with the invention of this patent each bearing of an automobile or other machine is provided with a lubricating hole, and into the outer end of each hole is permanently screwed a "pin fitting." The coupler part of a grease compressor is adapted for attachment in succession to each of the several pin fittings, whereby grease may be forced from the grease gun part of the combination through the coupler and the pin fitting and thence on into the bearing. When one bearing has been greased, the coupler is detached from the associated pin fitting and then attached to the pin fitting of the next bearing. In this way the single compressor is used to force grease into all of the bearings of the automobile in succession.

The claims of the Gullborg patent describe the various parts making up the complete combination of grease gun, coupler and pin fitting.

It is only the ultimate user who attaches the coupler of the grease compressor to the pin fitting associated with a bearing. It is only the ultimate user, therefore, who assembles the complete combinations of the claims of the patent.

To facilitate the attachment of the coupler some bearings must be equipped with "straight" fittings, some with "90° elbow" fittings, some with "45° elbow" fittings, etc. Some users are best served by compressors of small size, while others are best served by compressors of larger size. It is therefore advantageous and practically necessary to the ultimate users for the manufacturer to list and sell the various forms

of pin fittings and the various sizes of compressors separately, thus leaving it to the user to purchase the assortment best suited to his needs (Rec., p. 19).

In this respect the invention of the Gullborg patent is of an unusual character. The phonograph is the only close parallel. The Victor Company's Berliner patent involved in *Leeds & Catlin* v. *Victor,* 213 U. S. 301 and 213 U. S. 325, claimed the combination of the Victor Company's disc record and the tone arm and stylus of the phonograph machine. Various sizes and styles of phonograph machines were sold in great numbers by the Victor Company, as also a wide assortment of "records." Some users wanted Grand Opera records, others wanted Jazz tunes. Each purchaser was free to buy a large phonograph or a small one, and then separately to buy such an assortment of records as might suit his fancy. It was, however, only the ultimate user who ever brought together the complete combinations of the claims of the Berliner patent.

Leeds & Catlin made and sold the disc records of the Berliner combination. They were purchased by the owners of Victor talking machines and used in combination with the swinging tone arm and stylus of those machines as described in the claims of the Berliner patent. Leeds & Catlin were held to be contributory infringers of the Berliner patent because they sold the disc record part of the complete combination with the expectation and intention that the purchasers would combine this part with the other parts of the combination which had been sold by the Victor Company.

To camouflage the real intent with which Leeds & Catlin sold their disc records, they devised and manufactured, and to a slight extent sold, a phonograph machine which did not have the swinging tone arm of

the Victor patent, but in which the stylus was advanced by a screw thread feed. In accordance with the Berliner invention the stylus was advanced by the groove in the disc record, and the tone arm was mounted to swing freely in such a way as to permit this advancement of the stylus by the groove. When, as in the Leeds & Catlin machine, the stylus was not advanced by the groove of the disc record, but rather by the lead screw, the claims of the patent were avoided. Since, however, Leeds & Catlin's records found their principal market for use in connection with the Victor Company's talking machine, the further sale of these records was enjoined, and this despite the fact that when and if the Leeds & Catlin records were used in combination with the Leeds & Catlin screw feed machine, there would be no embodiment of the Berliner invention, and therefore no infringement of the claims of the Berliner patent.

This suit presents a close parallel. The defendants sold the fitting parts of the complete combination of the Gullborg patent with the expectation and intention that the purchasers would in use combine them with the compressor parts which had been sold by the plaintiff-respondent. The defendant-petitioners, Rogers and Dusenberry, also sold compressor and coupler parts of the complete combination with the expectation and intention that the purchasers would combine them with the pin fitting parts which had been sold by the plaintiff-respondent.

The pin fittings sold by Rogers and Dusenberry differed a little from the pin fittings sold by the Alemite Corporation. So also the compressor and coupler parts sold by Rogers and Dusenberry differed somewhat from the compressor parts sold by the Alemite Corporation.

Nevertheless, when the Rogers fitting was combined with the Alemite compressor there was a complete and perfect embodiment of certain of the claims of the Gullborg patent. When, on the other hand, the Alemite pin fittings were combined with the Rogers compressor and coupler, there was a complete and perfect embodiment of certain other claims of the Gullborg patent.

This was due to the fact that some of the claims of the Gullborg patent were relatively broad in their description of the pin fitting parts and relatively narrow in their description of the coupler parts of the whole, while other claims were relatively narrow in their description of the pin fitting parts and relatively broad in their description of the coupler parts of the combination. This variance in the scope with which the several parts of the complete combination were defined by the several claims of the patent, was in recognition of the fact that some of the advantages of the invention could be secured even if fittings of an inferior form were used, and that some of the advantages could be secured even when the coupler used was of an inferior form.

The Gullborg invention was in this respect like most inventions. There is a very best form. But the invention can be embodied in more or less inferior forms. The inferiority may appear in one part or it may appear in some other part of the entire combination. It is these considerations which have led inventors and their patent solicitors to draw a series of counts or claims of differing scope. Some claim is relatively specific as to one feature and relatively generic as to others, while another claim is relatively broad as to the first feature and relatively specific as to the second.

What the defendant-petitioners did was to make a fitting and to make a compressor which, if used together, could be asserted not to embody all of the details of any one claim of the Gullborg patent.

All of the parts were, however, given precisely such form, size and dimensions that they could be perfectly interchanged with and substituted for the corresponding parts of the Gullborg system as manufactured and sold by the Alemite Corporation. If it had been the real purpose and intention of Rogers and Dusenberry to have their fittings used only in combination with their compressors, they could easily have made their coupler and fitting parts a sixty-fourth of an inch larger in diameter or smaller in diameter. They could easily have made the distance from the pin to the head a sixteenth of an inch longer or a sixteenth of an inch shorter. Any of these or like departures from the exact dimensions of the Alemite equipment would have prevented interchangeability and conjoint use. In this event, however, the owner of an Alemite compressor could not "increase his repertory" by purchasing Rogers and Dusenberry fittings. He could not have lubricated his Alemite-equipped bearings by purchasing a Rogers and Dusenberry compressor.

What Rogers and Dusenberry wanted was the opportunity to sell their fitting parts and their compressor parts for use in combination with the other parts which were sold by the Alemite Corporation. Consequently the Rogers and Dusenberry parts were given precisely such dimensions as would insure the requisite interchangeability.

In the trial of the case in the District Court the testimony was directed exclusively to the question whether Rogers and Dusenberry were selling their parts with

the expectation and intention that the purchasers would combine them in use with the other parts sold by the Alemite Corporation. Rogers and Dusenberry contended that they sold all of their parts with the intention, and indeed with the instruction, that their fittings should be used only in conjunction with their compressors, and that their compressors should be used only in conjunction with their fittings. The Alemite Corporation offered evidence to show not only that the Rogers fittings could and would be used with the Alemite compressors, but that they had in many instances been sold under circumstances which could leave no doubt of that intention and expectation on the part of Rogers and Dusenberry. The Alemite Corporation offered like evidence as to the expectation and intention with which Rogers and Dusenberry sold their compressors.

The District Court decided that Rogers and Dusenberry had made all of their parts of such form and dimensions that they could be combined with the other parts of the combination as sold by the Alemite Corporation, and that they had been manufactured and sold with the expectation and intention that the purchasers would so combine them. (R., p. 127.)

It was the contention of the Alemite Corporation that the sales of these parts with such knowledge, expectations and intentions on the part of Rogers and Dusenberry was a contributory infringement of the Gullborg patent. It was the contention of Rogers and Dusenberry that they sold their parts with such other and different expectations and intentions that there was no contributory infringement.

This was the case in the District Court.

This was the case in the Court of Appeals.

Both courts decided the questions at issue in favor of the plaintiff-respondent.

Now let us compare this case, as decided by the lower courts, with the case which Rogers and Dusenberry present to this Court.

Nowhere in the petitioners' brief in this Court is it contended or even suggested that the petitioners did not sell their parts of the combination with the expectation and intention that the purchasers would combine them with the other parts which had been sold by the respondent. What the petitioners do now say in this Court is:

(1) That the Gullborg patent is invalid;

(2) That the plaintiff is violating "the spirit and the letter of the Anti-Trust Laws, and particularly Section 3 of the Clayton Act, 38 Stat. L. 731" (Petitioners' Brief, p. 30); and

(3) That the Alemite Corporation has impliedly licensed Rogers and Dusenberry to sell both the fitting parts and the compressor and coupler parts of the Gullborg combination.

None of these defenses was pleaded and advanced in the District Court, nor in the Court of Appeals. At the very outset of the trial in the District Court, and again in response to a specific inquiry by the Court, Rogers and Dusenberry expressly admitted and conceded the claims of the Gullborg patent to be valid. (R., pp. 98, 127.) No evidence was, therefore, offered by either party upon the question of the validity or invalidity of the Gullborg patent. No arguments were ever addressed to this question.

The plaintiff-respondent's alleged violations of the Clayton Act were not pleaded. Neither party offered any evidence upon the subject. The Anti-Trust Laws provide certain remedies for their violation. But such

violations cannot become a defense to a suit alleging patent infringement.

The defense of a license to Rogers and Dusenberry was not pleaded. The matter was not made the subject of any evidence by either party. The question was not advanced or argued in the lower courts.

Not one of these defenses is even suggested in the assignments of error. (R., pp. 131-132.)

On the other hand, all of the arguments advanced in this Court on behalf of the petitioners hinge upon one or more of these three contentions that the claims of the Gullborg patent are invalid, that the defendants are licensed, and that the plaintiff-respondent has violated the Clayton Act.

This Court is asked to decide these questions *de novo,* and to do so in a case where the questions were not put in issue by the pleadings, and in a case therefore where no evidence was directed by either party to the questions which this Court is now asked to decide.

The defense of non-infringement which the petitioners urge in this Court is based entirely upon the wholly new contention that all of the claims in suit of the Gullborg patent are invalid as they stand. It is at least tacitly conceded that the defendants contributorily infringed all of these claims as they appear in the patent in suit.

The argument is, however, that the claims are invalid. Wherefore, the Court is invited to rewrite the claims of the Gullborg patent into a narrow form by incorporating into them several new and additional elements. The Court is then invited to give to the new claims with these additional elements, an interpretation so narrow as to limit the claims to all of the details of all of the parts, precisely as shown in the drawings of the Gullborg patent.

When the enumerations of all of these elements and details are substituted for the claims as they exist in the Gullborg patent, then and then only are counsel for the petitioners in a position to urge, as they do, that there has been no infringement.

Even if it were permissible under the law, the addition of new elements to the claims of the patent in suit and the elimination of any range of equivalents for these several elements, are not required because of any patents or publications or inventions in the art prior to Gullborg as disclosed in the record in this case. They are not required because of any estoppels resulting from the prosecution of the application for the patent in suit. The history of the prosecution of the Gullborg patent is not even alluded to by counsel for the petitioner. The sum total of the "prior art" is represented by the Seng French patent No. 468,869, which appears on pages 272 to 275 of the record without even the courtesy of a translation.

Gullborg's patent No. 1,307,733 was issued on the same day as his patent No. 1,307,734. The two patents resulted from copending applications. What Gullborg disclosed in his first application of February 11, 1918, is not, of course, available to show that Gullborg was not the original and first inventor of anything shown in his second patent application of December 21, 1918, and is not, therefore, a part of the "prior art" which can be used to invalidate or limit Gullborg's patent No. 1,307,734. It was in recognition, doubtless, of the complete ineffectuality of Gullborg patent No. 1,307,733 and of the French patent to Seng to support the argument of counsel for the petitioners that the claims of Gullborg patent No. 1,307,734 are invalid unless limited to all of the precise details of the drawings and specifications of that patent, that

counsel have attempted to adopt the expedient of referring to the decisions of various courts in various other cases where allusion is made to various other patents of the prior art. These other prior art patents are not, however, available as any part of the record herein. Neither party had any opportunity to offer any evidence relative to them. These other patents were not before the District Court nor the Court of Appeals. This Court is asked, therefore, to consider them *de novo,* and then only upon the basis of what can be found in the opinions of other courts in other cases relative to them.

II.

A Detailed Showing of the De Novo Character of the Case Now Attempted To Be Presented in This Court Upon Questions Formally Abandoned or Not Pleaded or Not Raised or Discussed or Decided in the Lower Courts, or Not in Any Event Available in Defense To a Claim of Patent Infringement.

1. The Petitioners' Complete Abandonment in This Court of the Only Defense Which Was in Issue in the District Court.

The sole question which was in issue upon the trial in the District Court was decided by his Honor Judge Schoonmaker in the following language quoted from his opinion:

> "We find that the defendants are contributory infringers of the claims of the patent in suit through their sale of fitting or coupling elements of the combination covered by the patent, **with the purpose of bringing about its use in the patented combination.** The evidence on this point is quite

satisfying. The law is plain that the sale of an element of a combination for the purpose of bringing about its use in such a combination, constitutes the seller a contributory infringer: *Thompson-Houston* v. *Ohio Brass Co.*, 80 Fed. 712. It is equally well settled that it is a contributory infringement to sell parts of a complete combination for use in conjunction with other parts of that combination which had been furnished by the patentee: *Leeds & Catlin* v. *Victor*, 213 U. S. 301, and 213 U. S. 325.

"The precise type of contributory infringement charged in the instant case was before the Circuit Court of Appeals of the Second Circuit in *Bassick Mfg. Co.* v. *Adams Grease Gun Corporation*, 52 Fed. (2d) 36; and that Court upheld the infringement charge.

"We rest our conclusion in the instant case on the opinion of the Circuit Court of Appeals in that case." (R., pp. 127-8.)

The record (pp. 14 to 125) contains the testimony offered in the District Court. The foregoing opinion of Judge Schoonmaker decided the one issue raised by this testimony. The petitioners' complete abandonment of the one issue which was raised upon the trial is strongly indicated by the fact that throughout the entire brief in this Court on behalf of the petitioners, there is only one citation or reference to this record of the testimony in the District Court. That one reference appears on page 14 of the petitioners' brief. It is as follows:

> "At the time of trial, more than 544,000,000 of the patented pin-fittings had been sold by plaintiff (R., p. 18)."

Throughout the brief of counsel for the petitioners there are, indeed, only four other references to any part of the record:

On page 8, counsel for the petitioners refers to Gullborg's patent No. 1,307,733 printed at "(R., pp. 212-214)".

On page 21 of his brief counsel again refers to this Gullborg patent No. 1,307,733 "(R., pp. 212-14)".

On page 21 of his brief counsel refers again to this Gullborg patent No. 1,307,733 "(R., pp. 212-14)".

On page 21 he refers to "the French Seng patent No. 468,869 (R., pp. 272-5)".

Except for such facts as may be presented by Gullborg patent No. 1,307,733 and the French patent to Seng (which has never been regarded as of sufficient consequence to warrant even the offer or presentation of a translation), and by the one sentence in which it is said that the respondent had at the time of the trial sold more than 544,000,000 of its pin fittings, the factual matter upon which counsel carries his arguments is contributed wholly by himself.

At the risk of being somewhat tedious, but in an effort to show that the testimony in the District Court was limited to the one question of the intent with which the defendants sold their parts of the complete combinations of the Gullborg patent, we have thought it best at this point to incorporate a brief but complete résumé of all of the testimony adduced on both sides in the District Court.

A Brief Résumé of All of the Testimony Taken at the Trial.

Plaintiff's Testimony.

Plaintiff proved incorporation of plaintiff and change of name from Bassick Manufacturing Company to Alemite Manufacturing Company and to Alemite Corporation.

Title to patent in suit was admitted (R., p. 15).

DON ALEXANDER.
(R., p. 15.)

Identified samples of plaintiff's products manufactured and sold under patent in suit.

Identified samples of oil and grease cups used prior to advent of the Alemite system.

Alemite equipment was adopted by car manufacturers despite the fact it cost more than old-fashioned grease cups and oil cups.

Identified enlarged samples of Alemite pin fittings and couplers.

Gave figures showing sales of 544,000,000 Alemite pin fittings and 17,000,000 Alemite compressors with couplers, and gave amount of yearly sales in dollars amounting to a total of $44,632,159.02.

Explained plaintiff's methods of distributing its products.

Identified advertising literature bearing name of Rex Duplex Fitting Company (the defendants).

ROBERT H. KIDD.
(R., p. 24.)

Was formerly a defendant in this case and consented to the entry of a decree for a permanent injunction.

Was a salesman for Rogers and Dusenberry from January, 1932, to August, 1932.

Identified Plaintiff's Exhibit 16 as a compressor and coupler outfit of the kind he sold for Rogers and Dusenberry.

Identified Plaintiff's Exhibit 17 as the type of fitting Kidd sold for Rogers and Dusenberry.

> "I was instructed by Mr. Rogers, G. S. Rogers and Mr. Dusenberry to sell (compressors and couplers like Plaintiff's Exhibit 16) to garages, service stations and manufacturers of different kinds of

machinery where they used lubricating equipment for use on—they could be used with any standard make compressor and hose and coupler, or the Rex compressor, hose and coupler. . . . I could sell the compressor outfit separate or I could sell the fittings separate, either way. It didn't matter which way. I was told that the Rex compressor and coupler outfits could be used with the Alemite equipment or the Rex equipment, either way. I was instructed that the Rex fittings like Plaintiff's Exhibit 17 could be used for the Alemite compressor outfit or the Rex, either one."

These instructions were given by Dusenberry and Rogers.

Sold fittings alone to various named concerns and a few Rex compressor and coupler outfits to Wade's.

Kidd was not restricted in any way in his authority to sell Rex compressor and coupler outfits. Sometimes sold fittings alone, sometimes sold compressors and couplers alone. When he sold fittings alone he understood that the fittings were to be used in conjunction with Alemite compressor and coupler outfits like Plaintiff's Exhibit 5, and when he sold Rex compressor and coupler outfits like Plaintiff's Exhibit 16, he understood they were to be used in conjunction with Alemite fittings like Plaintiff's Exhibit 4.

Identified letters and advertising circulars sent out by Rogers and Dusenberry referring to Rex equipment like Plaintiff's Exhibits 16 and 17.

Marvin Walkow.
(R., p. 35.)

Employed by Wade's, Inc., a Pittsburgh lubrication service company which owned and used Alemite compressor outfits like Plaintiff's Exhibits 5 and 6, and a large Alemite electric compressor, each equipped with an Alemite coupler.

Walkow, for his company, purchased fifty 1/8" straight fittings like that of Plaintiff's Exhibit 20, and received as representing the transaction a receipt, Plaintiff's Exhibit 21 (R., p. 146) bearing date of May 16, 1932.

Defendants' fittings were placed in stock and were used by Wade's Service Station to replace fittings on automobiles. Lubricant was introduced to bearings equipped with defendants' fittings with the Alemite compressor outfits (R., p. 35).

EDWIN J. BALLUFF.
(R., p. 37.)

Made purchase of fifteen of defendants' fittings identified as Plaintiff's Exhibit 22 (R., p. 37) on September 17, 1932, from defendants' sales representative, Chicago Automotive Surplus Company, in Chicago. The sales slip is in evidence as Plaintiff's Exhibit 24 (R., p. 147).

Told defendants' sales representative at time of purchase that fittings were for use in conjunction with a lubricant compressor and coupler outfit which Balluff exhibited and which is in evidence as Plaintiff's Exhibit 23 (R., p. 37).

Device of Plaintiff's Exhibit 23 is illustrated in a drawing Plaintiff's Exhibit 34, duplicated at page 154 of the record. Plaintiff's Exhibit 23 is a Lyman compressor and coupler outfit of the kind enjoined pursuant to the opinion of the 6th C. C. A. (18 Fed. (2d) 29). (R., p. 51.)

NELSON CORNELL.
(R., p. 39.)

On September 16, 1932, Cornell purchased from defendants' sales representative in Chicago, Chicago Automotive Surplus Company, fifty of defendants' fittings, identified as Plaintiff's Exhibit 25 (R., p. 39), and received as representing the transaction a receipt, Plaintiff's Exhibit 26 (R., p. 148).

M. K. ULRICH.
(R., p. 42.)

On July 11, 1932, Mr. Ulrich purchased from defendants' sales representative, Robert H. Kidd, at Pittsburgh, one hundred of defendants' fittings, identified as Plaintiff's Exhibit 27 (R., p. 42), receiving as representing the transaction a receipt, Plaintiff's Exhibit 28 (R., p. 149).

Also identified Plaintiff's Exhibit 29 (R., p. 150), an advertisement of defendants' equipment published by Robert H. Kidd as sole agent.

THOMAS H. BRYSON.
(R., p. 44.)

Was an employe of Equitable Auto Company, the transportation unit of the Philadelphia Company, the large public service company operating the street railway and bus service. Equitable Auto Company serviced the numerous street-cars and automobiles with Alemite compressor outfits, both hand and motor operated equipments, all provided with Alemite couplers (R., p. 45).

Equitable Auto Company purchased one hundred of defendants' fittings like Plaintiff's Exhibit 17, on May 17, 1932 (R., p. 45).

Defendants' bill of sale, Plaintiff's Exhibit 31, appears at Record, p. 153, and the Equitable Auto Company's check in payment for the fittings, Plaintiff's Exhibit 30, appears at Record, p. 151.

Equitable Auto Company did not own any defendants' compressor and coupler outfits, and the defendants' fittings purchased by the Equitable Company were placed in stock with Alemite fittings already on hand and the defendants' fittings were used interchangeably with Alemite fittings (R., p. 47).

ELWOOD HANSMANN.
(R., p. 50.)

Familiar with litigation under the patent in suit. he identified Plaintiff's Exhibit 23, exhibited to defendants' Chicago sales representative by Balluff when Balluff made a purchase of fifteen fittings for use in conjunction therewith, as being a Lyman compressor and coupler outfit enjoined pursuant to the opinion of the 6th C. C. A. (18 Fed. (2d) 29).

Identified Plaintiff's Exhibit 34 (R., p. 154) as a drawing of the Lyman equipment which had been enjoined, and as a drawing of the compressor and coupler outfit exhibited by Balluff to defendants' sales representative in Chicago at the time Balluff purchased defendants' fittings (R., p. 52).

Identified cut-open specimen of defendants' fitting as Plaintiff's Exhibit 35 (R., p. 53).

Identified Plaintiff's Exhibit 36 as a drawing of defendants' compressor and coupler outfit like Plaintiff's Exhibit 16 (R., p. 53). The defendants' compressor and coupler outfit in this drawing is shown in conjunction with an Alemite pin fitting.

Defendants' Testimony.

Patrick C. Gasparin.
(R., p. 55.)

Employed by defendants as a machinist.

Identified an enlarged specimen of defendants' coupler and fitting offered in evidence as Defendants' Exhibit A.

Identified a drawing of defendants' coupler and fitting as Defendants' Exhibit B (R., p. 270).

R. W. Dusenberry.
(R., p. 60.)

Mr. Dusenberry, one of the defendants, undertook to testify relative to the defendants' custom in selling their equipment. His attempts to say that defendants' compressor and coupler outfits were sold only for use with defendants' fittings, and that defendants' fittings were sold only for use with defendants' compressor and coupler outfits, were pathetic (R., pp. 60 *et seq.*).

Testified that he was the proprietor of Rex Duplex Fitting Sales Company, a selling organization.

He purchased from G. S. Rogers, co-defendant, proprietor of Rex Duplex Fitting Company, having a factory at Oakmont, Pennsylvania (R., p. 63).

Admitted the sale of fittings alone to Equitable Auto Company, Wade's Service Station, Ulrich, City of Pittsburgh, and others (R., pp. 67, 68).

Identified specimens of defendants' sales literature (R., pp. 139, 140-A, 140-B, 267, 268).

J. Roy Van Kirk.
(R., p. 90.)

One of counsel for defendants.

He testified that he instructed defendants' salesmen that in the opinion of counsel the sale of defendants' compressor and coupler and fittings, when sold together, would not constitute an infringement of the Gullborg patent in suit (R., p. 91), but that the parts of the equipment might be sold separately (R., p. 92).

On cross-examination he said he did not know what the claims of the Gullborg patent were (R., p. 93).

C. L. W. Trinks.
(R., p. 96.)

Defendants' expert.

Re-identified drawing of defendants' coupler and fitting, Defendants' Exhibit B, reproduced at Record, p. 270 (R., p. 104), and described the construction.

Discussed the advantages of the Gullborg patent construction (R., p. 111), and compared the defendants' coupler and fitting with the Gullborg construction.

During Mr. Trinks' testimony, defendants' counsel offered in evidence as Exhibit D, Seng French patent No. 468,869 (R., pp. 272-275), the only patent offered in evidence in behalf of the defendants.

Don Alexander.
(R., p. 121.)

Plaintiff's witness in rebuttal.

Identified a specimen of the Alemite Zerk or push type equipment made and sold by plaintiff, fittings as Plaintiff's Exhibit 43 and compressor as Plaintiff's Exhibit 46. These exhibits were offered to identify what Mr. Dusenberry had referred to in his testimony in behalf of the defendants.

ELWOOD HANSMANN.
(R., p. 121.)

Mr. Hansmann, in rebuttal, familiar with plaintiff's patent litigation, testified that the Seng French patent No. 468,869 (R., p. 272), offered in behalf of defendants as Exhibit D, was before the courts in *Lyman et al.* v. *Bassick*, 18 Fed. (2d) 29; *Bassick* v. *United Grease Gun Corporation*, 40 Fed. (2d) 549; *Bassick* v. *Ready Auto Supply Company*, 22 Fed. (2d) 331; and *Bassick* v. *Adams Grease Gun Corporation*, 52 Fed. (2d) 36.

THIS RESUME OF THE TESTIMONY REVEALS THAT NONE OF THE ISSUES NOW ASSERTED IN THIS COURT WAS PRESENTED TO THE TRIAL COURT.

It is obvious from this testimony:

(*a*) That the validity of the Gullborg patent No. 1,307,734, was not in issue;

(*b*) That an implied license to the defendants was not in issue;

(*c*) That the plaintiff's alleged violation of the Clayton Act was not in issue; and

(*d*) That the only ground of the defendants' contention of non-infringement was that they did not sell their parts of the complete combinations with the expectation and intention that the purchasers would combine them with the other parts sold either by the plaintiff or by infringers (*e. g.*, Lyman Manufacturing Company) of the plaintiff's patent.

2. In the District Court and in the Court of Appeals, the Petitioners Expressly Admitted the Validity of the Claims of the Gullborg Patent in Suit; This Court Is Asked De Novo to Find That This Gullborg Patent Is Not Valid.

On page 15 of his brief counsel for the defendant-petitioners admits that the validity of the patent in suit was conceded in the lower courts in this cause,—and then blandly attempts to retract that concession. Counsel for petitioners says:

> "the validity of the patent in suit was conceded in the lower Courts in this cause. (Defendant-petitioner no longer concedes the validity of the patent in suit, but on the contrary also denies validity.)"

The validity of the Gullborg patent in suit was expressly conceded by the defendant-petitioners at the outset of the trial. The record does not include the opening statement of counsel for either party, but during the course of the testimony the Court asked counsel for the defendant-petitioners:

> "The Court: What is your position, Mr. Clarke, with reference to the patents in suit? Do you concede that the claims in suit are valid?
>
> "Mr Clarke (counsel for defendants): We are not contesting the validity, your Honor, **as I said at the outset.**
>
> "The Court: That is what I understood—that you were not contesting the validity.
>
> "Mr. Clarke: No, sir. Our defense is non-infringement." (R., p. 98.) (Emphasis ours.)

The District Judge, in his opinion, said:

> "The Gullborg patent covers a lubricating system of equipment, which has come to be practically

of universal use in the lubricating of automobiles.

"No question of its validity was involved in this suit. The patent has been held valid by many courts, and its validity was conceded at the trial." (R., p. 127.)

One of the District Court's findings of fact was that

"2) The said letters patent are good and valid in law." (R., p. 126.)

The decree of the District Court adjudged

"(2) That the said Letters Patent are good and valid in law." (R., p. 129.)

The defendant-petitioners' assignments of error to the Court of Appeals appear on pages 131-132 of the Record. Not one of the defendant-petitioners' assignments raised any question as to the holding of the decree or the finding of fact that the claims in suit of the Gullborg patent were valid.

Although the record in this Court does not contain the defendant-petitioners' brief nor petition for rehearing in the Circuit Court of Appeals, the opinion of that Court (R., p. 136) says that "The questions involved in the present case were discussed by the court below in its opinion" (R., p. 137), thus confirming our statement that the defendant-petitioners conceded the validity of the Gullborg patent in suit just as they had done in the District Court.

Despite the defendants' concession at the outset of the trial in the District Court that the claims in suit of the Gullborg patent were valid, and despite the fact that this concession was adhered to throughout the trial and the arguments in the District Court and in the Circuit Court of Appeals, still counsel for the defendant-petitioners asserts in this Court that "Defendant-petitioner no longer concedes the validity of

the patent in suit, but on the contrary also denies validity." (Petitioners' Brief, p. 15.)

Counsel then proceeds to urge the invalidity of the Gullborg patent on various scores.

Under Point I of his argument counsel for the petitioners says, on page 29 of his brief:

> "the claims are obviously invalid, as failing particularly to point out and distinctly to claim the alleged invention, as required by Section 4888 of the Revised Statutes."

Petitioners' Point III of their argument is likewise that "The claims in suit are fundamentally invalid." (Petitioners' Brief, p. 39.)

Under Point VI of his argument counsel for the defendant-petitioners says, on page 48 of his brief, "The case at bar is not one which would justify any indulgence in favor of the validity of the claims," and then asserts these claims to be "fundamentally invalid and violative of the essential principles of patent law" (Petitioners' Brief, p. 49), for any one or all of several asserted reasons.

Under Point VII of the argument on behalf of petitioners, counsel discusses "The practical effect of sustaining plaintiff-respondent's contention as to the validity and scope of the claims in suit" (Petitioners' Brief, p. 50), depicting various imaginative calamities which will ensue.

Finally, in the first and last paragraphs of his "Conclusion," counsel for the petitioners urges upon this Court that "the claims in suit must be held invalid as not defining or as not limited to plaintiff's alleged contributions" (Petitioners' Brief, p. 53), and that this Court "strike at the root of the evil by holding the claims invalid" (Petitioners' Brief, p. 55).

THIS COURT WILL NOT PASS UPON AN AFTERTHOUGHT ISSUE NOT RAISED OR CONSIDERED IN THE LOWER COURTS AND URGED IN THIS COURT FOR THE FIRST TIME.

Minnich v. *Gardner,* 292 U. S. 48, 53, 78 L. Ed. 1116, 1119. (April 2, 1934—Opinion by Mr. Justice Sutherland.)

David Burnet v. *Commonwealth Improvement Co.,* 287 U. S. 415, 417, 77 L. Ed. 399, 402. (Dec. 12, 1932—Opinion by Mr. Justice McReynolds.)

United States v. *LaFranca,* 282 U. S. 568, 75 L. Ed. 551, 557. (February 24, 1931—Opinion by Mr. Justice Sutherland.)

Hathaway & Co. v. *United States,* 249 U. S. 460, 464, 63 L. Ed. 707, 709. (April 14, 1919—Opinion by Mr. Justice Brandeis.)

Virtue v. *Creamery Package Mfg. Co.,* 227 U. S. 8, 38, 57 L. Ed. 393, 407. (January 20, 1913—Opinion by Mr. Justice McKenna.)

Green County v. *Thomas' Executor,* 211 U. S. 598, 53 L. Ed. 343, 345. (January 4, 1909—Opinion by Mr. Justice Moody.)

Great Northern Railway Co. v. *United States,* 208 U. S. 452, 52 L. Ed. 567, 577. (February 24, 1908—Opinion by Mr. Justice White.)

United States v. *American Tobacco Co.,* 166 U. S. 468, 479, 41 L. Ed. 1081, 1085. (April 12, 1897—Opinion by Mr. Justice Peckham.)

Badger v. *Ranlett,* 106 U. S. 255, 258, 27 L. Ed. 194, 196. (December 11, 1882—Opinion by Mr. Justice Blatchford.)

George M. Wheeler v. *John Sedgwick,* 94 U. S. 1, 24 L. Ed. 31, 32. (Decided Nov. 20, 1876—Waite, C. J.)

Supervisors v. *Lackawanna Iron and Coal Co.,* 93 U. S. 619, 23 L. Ed. 989, 991. (January 22, 1877—Opinion by Mr. Justice Davis.)

Albert Klein v. *Nathan C. Russell,* 86 U. S. 433 463, 22 L. Ed. 116, 124. Mar. 3, 1874—Opinion by Mr. Justice Swayne.)

Houghton et al. v. *Jones,* 68 U. S. 702, 705, 17 L. Ed. 503, 504. (Decided Dec. 28, 1863—Opinion by Mr. Justice Field.)

Insurance Co. of Valley of Virginia v. *Mordecai,* 63 U. S. 111, 16 L. Ed. 329, 332. (Opinion by Mr. Justice Nelson.)

United States v. *Thomas O. Larkin et al.,* 59 U. S. 557, 561, 15 L. Ed. 485, 487. (Decided May 12, 1856.)

James C. Bell et al. v. *Matthias Bruen,* 42 U. S. 169, 187; 11 L. Ed. 89, 96. (Opinion by Mr. Justice Catron.)

The petition for a writ of certiorari was not based upon the lower courts' acceptance of the petitioners' concession of validity. It was not based upon any alleged conflict of decision between any two circuit courts of appeals relative to the validity of the claims of the Gullborg patent. The petitioners' contention of invalidity is therefore quite outside the scope of the petition for a writ of certiorari. There was, indeed, no conflict of opinion relative to this matter of validity upon which a petition for a writ of certiorari could have been based.

THIS COURT WILL NOT CONSIDER A QUESTION NOT RAISED IN AND BY THE PETITION FOR WRIT OF CERTIORARI.

"Since both courts in the Sanitary case held the five specific claims to be valid, and neither court in the Dent case held them to be invalid, and the Hardware Company, in defending for the Refrigerator Company in the Sanitary case and for itself in the Dent case, admitted in both circuit courts of appeals that these claims were valid if limited to the specific structure disclosed, we have no occasion here to determine the question as to the validity of these claims when thus limited; especially as the petition for certiorari in the Sanitary case did not question the decree of the circuit court of appeals for the seventh circuit in respect to the validity of these claims, but assigned as error merely its holding in reference to the question of infringement and was based solely on the conflict between the two circuits in respect to that question." —*Sanitary Refrigerator Co.* v. *Winters,* 280 U. S. 30, 34, 74 L. Ed. 147, 152. (October 14, 1929—Opinion by Mr. Justice Sanford.)

Benjamin F. Johnson v. *Manhattan Railway Co.,* 289 U. S. 479, 494, 77 L. Ed. 1331, 1343. (May 29, 1933—Opinion by Mr. Justice Van Devanter.)

Gunning v. *Cooley,* 281 U. S. 90, 98, 74 L. Ed. 720, 726. (March 12, 1930—Opinion by Mr. Justice Butler.)

Ben W. Steele v. *J. H. Drummond,* 275 U. S. 199, 203, 72 L. Ed. 238, 239. (Nov. 21, 1927—Opinion by Mr. Justice Butler.)

James C. Davis v. *J. M. Currie,* 266 U. S. 182, 183, 69 L. Ed. 234. (Nov. 17, 1924—Opinion by Mr. Justice McReynolds.)

Webster Electric Co. v. *Splitdorf Electrical Co.*, 264 U. S. 463, 464, 68 L. Ed. 792, 793. (April 7, 1924—Opinion by Mr. Justice Sutherland.)
Alice State Bank v. *Houston Pasture Company*, 247 U. S. 240, 62 L. Ed. 1096, 1098. (June 3, 1918—Opinion by Mr. Justice Holmes.)

3. THE PETITIONERS CONTEND IN THIS COURT FOR THE FIRST TIME THAT THEY WERE IMPLIEDLY LICENSED BY THE PLAINTIFF-RESPONDENT. THIS DEFENSE OF "LICENSE" WAS NOT PLEADED. NEITHER PARTY OFFERED ANY EVIDENCE RELATIVE TO IT. NEITHER THE DISTRICT COURT NOR THE COURT OF APPEALS WAS ASKED TO CONSIDER IT.

Counsel for petitioners contends that if the claims of the patent in suit are not held invalid, then they should be held not infringed "by holding that the unconditional sale by plaintiff of its pin-fittings under its earlier patent No. 1,307,733 (not in suit) carries with it an implied license" to the (petitioners) "to connect with it" what is described as the petitioners' grease gun. (Petitioners' Brief, p. 54.) Again it is contended that if the patent be not held invalid, then it "must be held not infringed" on the ground "that plaintiff's unconditional sale of its suction-effect grease-guns sold by it under claims 1, 2, 3, 4 and 8 of the patent in suit, carries with it the implied license to use them on" what counsel chooses to call "any old and unimproved and unpatentable bayonet-type grease-cups of competitors," *i. e.*, the petitioners. (Petitioners' Brief, p. 54.)

The above-quoted passages are taken from the "Conclusion" of counsel's brief. This same defense

of "an implied license" is urged also in the body of the brief, *e. g.*, on pages 19, 29, 36, 37, 47 and 54.

The petitioners' plea of an implied license is presented in this Court for the first time. No such defense was considered by the District Court (R., p. 127) nor by the Court of Appeals (R., p. 136). No such defense was made the subject of any assignment of error to the Court of Appeals (R., p. 131).

Indeed, the defendants' answer (R., p. 7) can be searched in vain for any suggestion or plea of any kind of a license or any kind of an estoppel which would prevent the plaintiff from asserting the monopoly accorded by its patent.

Under the issues as raised by the pleadings, the petitioners could not have urged the defense of an implied license or an estoppel in the lower courts.

That the defense of license is one which must be specially pleaded and cannot be asserted under any general denial, is obvious under the most general rules of pleading. The text writers treat the rule in this regard as elementary. Thus, Walker on Patents, Sixth Edition, at page 738, says:

> "The 23rd defense, that the defendant has a license, must be set up in the answer, and the burden of proving such defense is upon the defendant."

The rule as stated by Walker is well established in the Federal Courts. In the early case of *Puetz* v. *Bransford*, 31 Fed. 458, Judge Thayer, on circuit in Missouri, said at page 464:

> "In deciding the case, the court is, of course, confined to those issues which have been raised by the pleadings. It may be that the firm of Bransford & Puetz became equitably entitled to patent No. 50, as part of the firm assets, by virtue of the

> partnership agreement, or that a license to the defendant to use the device covered by the third claim of said patent might be inferred from the manner in which the partnership business was conducted for a period of several months. But defendant has not pleaded property in the invention acquired in virtue of the partnership agreement, or a license to use the invention, or any facts which estop the complainant from asserting an exclusive right to make and sell the device covered by the third claim of the patent in question. The court is accordingly precluded from passing judgment on such defenses, although such defenses have been in effect made in the course of the argument."

The Federal equity rules coming into force subsequent to that decision did not change the necessity for affirmatively pleading such a defense, although they did alter the form in which such a defense was to be presented. Equity Rule 29, referring to such defenses, says:

> "Every defense heretofore presentable by plea in bar or abatement shall be made in the answer and may be separately heard and disposed of before the trial of the principal case in the discretion of the court."

That a plea of license was presentable by a plea in bar under the old rules of practice, there can be no doubt, for if a license were asserted by the defendant and proved, there would be no necessity for a trial on any other merits or any investigation of questions of validity and infringement of the patents in suit. This has been well recognized in the Federal Courts. In the comparatively recent case of *General Talking Pictures Corp.* v. *Stanley Co.,* decided in 1930, the opinion appearing in 38 Fed. (2d) 355, Judge Morris said:

> "The license agreement relied upon is general

in its terms, and includes 'any and all inventions relating to apparatus, methods or systems adapted for use in wire or radio signaling or communication, or relating to the audion or other vacuum, rarified gas or vapor electric discharge device, or relating in any wise to electrical translating devices (such, for example, as ocillation generators, relays, repeaters, amplifiers, detectors, rectifiers, power limiting devices, X-ray apparatus, etc.), which may be made or conceived by Lee De Forest during the period of seven years from and after the date hereof.'

"The substantive issue at the hearing upon this defense, which, notwithstanding it is directed to two only of the four patents in suit, would have been presentable by a plea in bar under the former rules, Story's Eq. Pl. secs. 647, 693, would be whether the inventions of the two patents under which a license is claimed are within the scope of this agreement.

"As the true end of a plea under the former rules, which required that it reduce the cause or the part to which it applied to a single point, was to save to the parties the expense of an examination of the witnesses at large, Story's Eq. Pl. sec. 652, so the true purpose of the provision in Rule 29 (28 USCA, sec. 723) for separate trial, in the discretion of the court, of a defense formerly presentable by plea, is likewise to save to the parties the expense of preparation and trial at large. Consequently, the question presented by the pending motion is whether a separate trial of the defense of license would probably inure substantially to the benefit of the parties."

Neither under the present equity rules nor under the rules of pleading as they existed prior thereto, can a defense of license be asserted or considered by the Court unless such a defense is affirmatively pleaded and set forth in the answer.

THE SUPREME COURT WILL NOT CONSIDER A DEFENSE WHICH HAS NOT BEEN PLEADED.

George F. Potter et al. v. *United States,* 107 U. S. 126, 131, 27 L. Ed. 330, 332. (January 15, 1883—Opinion by Mr. Justice Woods.)

Bates v. *Coe,* 98 U. S. 31, 47, 25 L. Ed. 68, 74. (November 25, 1878—Opinion by Mr. Justice Clifford.)

4. THIS COURT WILL NOT CONSIDER THE PETITIONERS' CONTENTION THAT THE PLAINTIFF'S USE OF ITS PATENT "IS VIOLATIVE OF THE SPIRIT AND LETTER OF THE ANTI-TRUST LAWS AND PARTICULARLY SECTION 3 OF THE CLAYTON ACT, 38 STAT. L. 731," BECAUSE (1) THIS DEFENSE WAS NOT PLEADED, (2) NEITHER PARTY OFFERED NOR HAD AN OPPORTUNITY TO OFFER ANY EVIDENCE RELATIVE TO IT, AND (3) ALLEGED VIOLATIONS OF THE ANTI-TRUST LAWS MAY NOT BE URGED AS A DEFENSE TO A CLAIM OF PATENT INFRINGEMENT.

The Clayton Act specifies the procedures which may be employed in its enforcement, and provides certain specified remedies which private parties may invoke in connection therewith. Its penalties and provisions cannot otherwise be invoked. The defendant's answer in this case (R., pp. 7-14) is devoid of any suggestion of any violation of any provision of the Clayton Act. Neither party offered any evidence in support of the petitioners' present contention in this Court nor in rebuttal thereof. Neither the decree nor the findings of fact nor the conclusions of law of the District Court referred in any way to the Clayton Act, nor to any

alleged violation or attempted violation of it. Furthermore, it is the well-settled rule of the Federal Courts throughout the country that alleged violations of the Clayton Act or other "Anti-Trust" laws cannot be pleaded in defense to suits for patent infringement.

"The action is clearly for infringement of patent rights, and many decisions cited in plaintiffs' brief are unanimous in holding that violations of the anti-trust laws in a patent suit for infringement are not a proper defense." —*Western Electric Co., Inc., et al.* v. *Wallerstein*, 48 Fed. (2d) 268. (D. C. W. D. N. Y.—1930. Opinion by Hazel, D. J.)

"It is well settled by a long line of decisions that it is no defense to a bill for alleged infringement of a patent that plaintiffs have entered into a combination or conspiracy among ourselves or with third parties to violate the anti-trust laws of the United States." (Citing many cases.) —*Radio Corporation of America et al.* v. *Majestic Distributors, Inc.*, 53 Fed. (2d) 641, 642. (D. C. D. Conn. Oct. 1, 1931—Thomas, D. J.)

"in a suit brought for the infringement of a patent by the owner, any such inquiry, at the behest of the infringer, would be as impertinent as one in respect to the moral character or antecedents of the plaintiff in an ordinary suit for trespass upon his property." —*Strait et al.* v. *National Harrow Co.*, 51 Fed. 819, 820. (C. C. N. D. N. Y., 1892—Opinion by Wallace, C. J.)

"The present complainants are entitled by the patent laws to a monopoly, for the term of the patent, of the manufacture and sale of the lamps made under it. The right to this monopoly is the very foundation of the patent system. They do not lose that right merely because they may have joined in a combination with others, holding other patents securing similar monopolies, which com-

bination may, when judicially examined in a proper forum, be held to be unlawful." —*Edison Electric Light Co. et al.* v. *Sawyer-Man Electric Co.*, 53 Fed. 592 (C. C. A. 2, 1892—Opinion Per Curiam.)

"The question of law which stares us in the face is this: Does an allegation that the complainant is a party to an unlawful conspiracy, which tends to restrain trade and oppress the defendant in its business, afford any defense to a suit for the infringement of letters patent, the title to which is vested in the complainant?

"This question has been answered in the negative by the courts with such unanimity and decisiveness that it would be wasted energy for me to do more than cite *National Folding Box & Paper Co.* v. *Robertson* (C. C.), 99 Fed. 985. . . .

"To leave the paragraph in, because it sets up an alleged substantive defense, which has been, time and again, decided by the courts to be a futile defense, would be, to my mind, an idle thing and a travesty. . . .

"The motion to strike out (paragraph of answer) is granted." —*Johns-Pratt Co.* v. *Sachs Co. et al.*, 176 Fed. 738, 739. (C. C. D. Conn. 1910—Opinion by Platt, D. J.)

See also:

Radio Corporation v. *Duovac Radio Tube Corporation*, 6 Fed. Supp. 275. (D. C. E. D. N. Y., June 17, 1931—Campbell, D. J.)

Dr. Miles Medical Co. v. *Platt, etc.*, 142 Fed. 606, 610. (C. C. N. D. Ill. 1906, Kohlsaat, C. J.)

Fraser v. *Duffey et al.*, 196 Fed. 900, 903. (D. C. D. Mass., 1912—Opinion by Colt, C. J.) Citing many cases.

Brown Saddle Co. v. *Troxel*, 98 Fed. 620, 621. (C. C. N. D. Ohio, E. D., 1899—Taft, C. J.)

United States Fire Escape Counterbalance Co. v. *Joseph Halsted Co.*, 195 Fed. 295. (D. C. N. D. Ill., E. D., 1912—Opinion by Sanborn, D. J.)

Motion Picture Patents Co. v. *Ullman, et al.*, 186 Fed. 174, 175. (C. C. S. D. N. Y., 1910—Holt, D. J.)

Independent Baking Powder Co. v. *Boorman*, 130 Fed. 726, 727. (C. C. D. N. J., 1904—Gray, C. J.)

Motion Picture Patents Co. v. *Eclair Film Co.*, 208 Fed. 416. (D. C. D. N. J., 1913—Opinion by Rellstab, D. J.)

5. The Grounds Upon Which the Petitioners Now Urge "Non-Infringement" in This Court Are Entirely Different From Those Upon Which They Urged "Non-Infringement" in the Lower Courts.

As we have seen, the petitioners' contention in the lower courts was that they did not sell their parts of the complete lubricating system with the expectation and intention that the purchasers would combine them in use with the other parts described in the claims of the Gullborg patent in suit. The lower courts decided that contention against the petitioners.

Their present contentions of "non-infringement" are upon entirely different grounds; namely, that the claims of the Gullborg patent are invalid; that they can be made valid only by importing into them a number of additional elements and details; and that when they are thus judicially rewritten in narrow form, the combinations of those parts sold by the petitioners with those parts sold by the plaintiff do not embody the claims as proposedly rewritten.

III.

There Is No Merit in Any of the Petitioners' New Theories of Non-Infringement; Which Theories Are Presented to This Court for the First Time During the Course of This Suit.

The theories of "non-infringement" now advanced by the petitioners in this Court were never advanced in the District Court nor in the Court of Appeals. They are newly concocted theories. This Court is invited to pass upon them for the first time.

Before taking up the petitioners' newly concocted theories of alleged "non-infringement," we should like to present as clearly as possible the factual situation relative to the claims in suit of Gullborg patent No. 1,307,734, and relative to the bearing of the claims upon the combinations resulting from the use of the petitioners' fittings and compressors in conjunction with the plaintiff's compressors and fittings.

The Invention and Claims of the Gullborg Patent in Suit.

The plaintiff offered in evidence as Plaintiff's Exhibit 39 (R., pp. 162 to 216) a certified copy of the file-wrapper and contents of Gullborg patent No. 1,307,733. The application for this patent was filed on February 11, 1918. Figure 2 of the drawing of this Gullborg patent No. 1,307,733 (R., p. 216) discloses a pin fitting comprising a tubular member flanged inwardly at one end to provide a closure seat, a closure or ball, a pin extending transversely through the tubular member, and a spring confined between the ball and pin. The fitting in this Gullborg patent No. 1,307,733 is shown

in conjunction and combination with a grease compressor comprising a grease gun terminating in a coupler, which in turn comprises a hollow shell with bayonet slots adapted to coact with the ends of the cross-pin of the fitting in such a way as to draw the head of the fitting tightly into engagement with the gasket 37 which is located at the bottom of the bore of the coupler shell.

Some months after this first Gullborg application was filed in the Patent Office on February 11, 1918, Gullborg devised an improved lubricating system in which the coupler had a spring-pressed sliding gasket or sealing member which would produce a suction effect which was useful in removing the excess lubricant from the head of the fitting. He therefore filed a second patent application on December 21, 1918, disclosing the complete combination of compressor and pin fitting, but now substituting the suction effect coupler for the non-suction effect coupler of the first application of February 11, 1918.

The two applications were copending in the Patent Office and were prosecuted together. What are now claims 14 and 15 of the Gullborg patent in suit No. 1,307,734, were initially claims 9 and 10 of the first application as originally filed. (See file-wrapper, R., pp. 172-173, Plaintiff's Exhibit 39.) The numbering of these claims 9 and 10 was changed to 5 and 6, and by amendment of March 20, 1919, these claims were renumbered 3 and 4 (R., pp. 180, 197). Throughout the prosecution of the patent application, these claims 9 and 10 as originally submitted to the Patent Office upon the filing of the application were never amended or modified in the slightest degree.

The plaintiff also offered in evidence the file-wrapper and contents of the Gullborg patent in suit No.

1,307,734 (Plaintiff's Exhibit 40). This history of the prosecution of the application for the patent in suit appears at pages 217 to 266, inclusive, of the record. The Commissioner of Patents formally "allowed" this second patent application on March 29, 1919 (R., p. 253).

Twenty-one days later, on April 19, 1919, Gullborg's first application was formally allowed (R., p. 210).

As matters then stood, two Gullborg applications had been allowed, both containing claims upon complete combinations of elements making up the compressor and fitting. The claims in the two applications differed in scope, but nevertheless both applications contained claims to a complete combination including the parts of the pin fitting, the grease pump and the coupler. In order to avoid any possible charge of double patenting (a defense which has been successfully made against the claims of two separate patents to the same inventor, differing only in scope), it was necessary to transfer claims 3 and 4 (original claims 9 and 10) of the earlier application to the later application before the patents issued.

Under the rules of the Patent Office it was not possible to transfer *all* of the claims of the later application to the earlier application, nor was it possible to transfer *all* of the claims from the earlier application to the later application.

It was not possible to transfer all of the claims from the later application to the earlier application, because the allowed claims in the later application included among their elements, "a perforated sealing disk slidably mounted in the enlarged portion of said bore, and a spring confined between the ends of said conduit and said disk for urging said disk against said first

named coupling member," etc., (*i. e.*, the improvements which gave rise to the "suction effect" cleansing of the fitting at the moment of disunion) and these things were not disclosed in the drawings or specifications of the earlier application as originally filed. Their inclusion in the combination had not, indeed, been invented until some time after the filing of the earlier application. It was not permissible to include in the earlier application, claims which were not "supported" by the accompanying specification and drawings as filed. It was not permissible to add to the drawings and specifications of the application filed on February 11, 1918, the things which Gullborg had not invented until a later date.

On the other hand, all of the claims of the earlier application could not be transferred to the later application for the reason that the Patent Office rules (based upon considerations of classification and indexing for searching purposes), did not permit claims drawn to two different "species" to be issued in any single patent. When both applications were allowed, the earlier application contained some claims to the pin fitting part of the combination (*e. g.*, claim 3 of patent No. 1,307,733). The other application contained one or more claims to another species, *i. e.*, the suction effect compressor (*e. g.*, claim 7 of patent No. 1,307,734).

It was, however, permissible, and it was desirable for the reasons previously stated, to put into one patent all of the claims which covered the complete combination of compressor and fitting, regardless how the various claims to this complete combination might differ in scope. Accordingly, therefore, on April 30, 1919, claims 3 and 4 (claims 9 and 10 as originally filed) were cancelled out of the earlier application (see

R., pp. 206-207). On the same date the same claims were incorporated by amendment in the later application as claims 14 and 15 (R., pp. 246 to 250).

After the transfer of the present claims 14 and 15 of patent No. 1,307,734 had been made from the earlier Gullborg application to the later Gullborg application, the final fees in both applications were paid and the two Gullborg patents issued on June 24, 1919, as Nos. 1,307,733 and 1,307,734.

Claims 14 and 15 of Gullborg patent No. 1,307,734, having been prosecuted and allowed in the application for patent No. 1,307,733, in precisely the form in which they were originally filed in that application on February 11, 1918, must be read and interpreted in consonance with the disclosure of the earlier application, *i. e.*, in consonance with the disclosure of the drawings and specifications of the application for Gullborg patent No. 1,307,733. The drawings and specifications of the earlier application in which these claims 14 and 15 were originally made, prosecuted, and finally allowed, did not disclose the slidably mounted sealing disk nor the associated spring which provide the "suction effect" of the combination subsequently invented by Mr. Gullborg and disclosed for the first time in his later application of December 21, 1918.

These claims 14 and 15 of the Gullborg patent in suit No. 1,307,734, having originally been filed in the earlier application of February 11, 1918, must necessarily apply to the things which were disclosed in the drawings and specifications of that earlier application. They could not, therefore, narrowly and specifically describe as elements of the combination, the sliding sealing disk and the confined spring which were not disclosed in the earlier application as filed, and which,

indeed, had not even entered Gullborg's mind until long after February 11, 1918, on which date that application was filed.

These claims 14 and 15 of the Gullborg patent in suit No. 1,307,734 were written in precisely their present form and filed in the Patent Office on February 11, 1918. They thus appear in the Gullborg patent application as filed on February 11, 1918, at pages 172-173 of the Record (claims 9 and 10 of the original application).*

Claims 14 and 15 of the Gullborg patent in suit are comparatively specific in their description of the pin fitting parts of the complete combination. They are relatively broad in their description of the coupler parts of the complete combination. They were necessarily broad in their description of the coupler parts of the combination because the suction effect details of the coupler, *i. e.*, the sliding sealing disk and its confined actuating spring had not even been conceived of at the time these claims were written.

Claims 1, 2, 3, 4 and 8 of the Gullborg patent in suit are, on the other hand, comparatively broad in their description of the pin fitting parts of the complete combination. They are relatively narrow in their description of the coupler parts of the complete combination because they include those elements which give rise to the suction effect, *e. g.*, the sliding sealing disk and the confined spring associated therewith,—things which were not disclosed in the earlier application of Feb-

* To say that these claims 14 and 15 as thus drawn and filed in the Patent Office on February 11, 1918, are to have the sliding sealing disk and the confined spring of the "suction effect" coupler imported into them by construction or interpretation, is tantamount to saying that these claims describe specifically and are limited to an invention which had not even been conceived of until months after the claims were drawn in precisely their present form and filed in the Patent Office on February 11, 1918.

ruary 11, 1918, and, indeed, things which had not even been conceived of at the time that earlier application was filed.

All of these claims are broad in their description of the grease pumping part of the complete combination.

The Sixth Circuit Court of Appeals (comprising a bench made up of Judges Denison, Donahue, Moorman and Tuttle) had all of these claims before it in a succession of six suits against Larkin Automotive Parts Company and O. K. Manufacturing Company and Peerless Automatic Machine Company and Lyman Manufacturing Company, and Riggs Tire & Supply Company and Wag's Auto Accessories Company, which were separately argued at various times over a period of a year. All of these cases were decided in the single opinion reported at 18 Fed. (2d) 29. All of these claims were sustained and found to be infringed by one or more of the defendants before the court in those cases. All of these same claims have been sustained and held infringed in numerous other cases in which the defendants' equipment was legally identical with that of the petitioners in the present suit.

Claim 12 of the Gullborg patent No. 1,307,734 was held invalid by the Sixth Circuit Court of Appeals in the opinion reported at 18 Fed. (2d) 29, at page 36. Accordingly, this claim was disclaimed by plaintiff (R., pp. 257-258, 264). Any intimation that the other claims of the Gullborg patent in suit are of the same tenor or scope as claim 12, must be based upon a very casual consideration of the claims of the Gullborg patent and the holding of the Sixth Circuit Court of Appeals, because in its opinion (18 Fed. (2d) at p. 36) the Court said:

> "In claim 12 there is no novelty over Winkley, excepting that the interposed gasket is held against

> one of the members by the pressure of the lubricant. This claim, for the reasons just stated, is invalid."

The preceding sentences of the Court of Appeals' opinion give those reasons, as follows:

> "So far, therefore, as any claim in Gullborg depends upon the suction result, it is valid; so far as it must rest *solely* for its novelty upon the pressure produced adhesion, it is invalid. Of the claims in suit, Nos. 1, 2, 3, 4, 7 and 8 by their reference to a perforated sliding disk or cup washer or means for removing excess lubricant, sufficiently imply dependence upon the construction which will give this novel suction effect."

The construction by which the suction and cleansing effect is obtained is recited in claims 1, 2, 3, 4 and 8. The Sixth Circuit Court of Appeals pointed out that the means for producing the suction effect, *i. e.,* the "perforated sliding disk or cup washer," was not included in claim 12. When, however, the Sixth Circuit Court of Appeals pointed out that claim 12 was directed *solely* to the construction by which the pressure-produced adhesion was obtained, it had in mind that this claim 12 did not contain certain other limitations recited in claims 14 and 15 which in and by the same opinion were expressly held to be valid. These other features which were included in claims 14 and 15, but which were not included in claim 12, were of course such things as "a tubular member having one end flanged inwardly to provide a closure seat, a closure, a pin extending through said tubular member and from both sides thereof, and a spring confined between said pin and said closure, and tending to hold said closure on its seat" (claim 14). None of these elements is recited either broadly or narrowly in claim 12.

There is obviously no reason why any of the elements

of claims 1, 2, 3, 4, and 8, or any of the elements of claims 14 and 15, should be deleted from those claims in order to make them more or less substantially identical with claim 12. To do so would be to rewrite them arbitrarily for the very purpose of holding them invalid upon the ground that they, like claim 12. are too broad.

On the other hand, there is no reason why claims 1, 2, 3, 4, and 8, should be rewritten by incorporating into them all of the additional elements recited in claims 14 and 15, and no reason for incorporating into claims 14 and 15 all of the additional elements recited in claims 1, 2, 3, 4, and 8. To do so would be simply to rewrite Gullborg's patent into the narrowest possible form for the arbitrary purpose of enabling the defendant-petitioners to say that they have not infringed.

THE INFRINGING MECHANISMS AND THE APPLICATION OF CLAIMS 1, 2, 3, 4, AND 8, AND THE APPLICATION OF CLAIMS 14 AND 15 THERETO.

The respondent charges the defendant-petitioners with contributory infringement of claims 1, 2, 3, 4 and 8 by their sale of fittings like Plaintiff's Exhibit 17,* adapted and intended and sold for use in conjunction with respondent's Alemite compressor and coupler outfits like those submitted as Plaintiff's Exhibits 5 and 6.*

Respondent charges defendant-petitioners with contributory infringement of claims 14 and 15 of the Gullborg patent by the petitioners' manufacture and sale of compressor and coupler outfits like Plaintiff's Exhibit 16,* adapted and intended and sold for use in conjunction with respondent's Alemite pin fittings of the type submitted as Plaintiff's Exhibit 4.*

* These several exhibits are before the Court as physical exhibits.

Gullborg Patent 1,307,734.

CLAIM 1.

The combination with a hollow coupling member having a pin projecting from one side thereof and a spring-pressed closure,

of a pump having a flexible conduit connected with the outlet thereof,

a second hollow coupling member secured to the other end of said conduit for receiving the closed end of said first named coupling member and provided with a bayonet slot for receiving said pin,

the transverse portion of said slot being inclined from the longitudinal portion thereof toward the outer end of the coupling member,

the bore of said coupling member being enlarged to provide a shoulder,

a perforated sealing disk slidably mounted in the enlarged portion of said bore,

and a spring confined between the ends of said conduit and said disk for urging said disk against said first named coupling member.

CLAIM 2.

The combination with a hollow coupling member having a pin projecting from one side thereof and a spring-pressed closure,

of a pump,

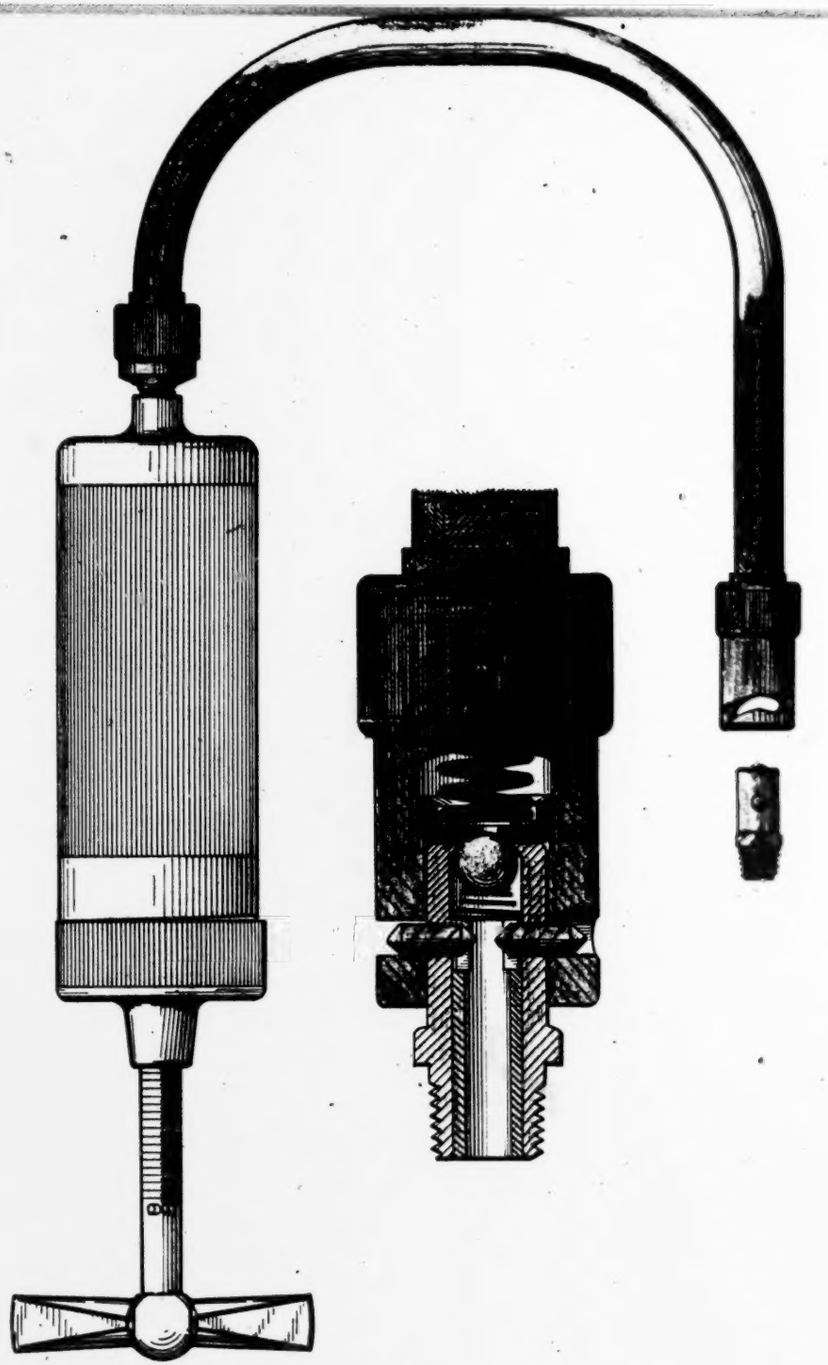
a discharge conduit having one end secured to the outlet of said pump,

a second hollow coupling member for receiving the closed end of said first named coupling member secured to the other end of said conduit and provided with a bayonet slot adapted to co-act with said pin,

a perforated sealing disk mounted to reciprocate in the bore of said coupling member,

means for yieldingly urging said sealing disk against the closed end of said first named coupling member,

and means for limiting the movement of said sealing disk in the direction of said second coupling member.



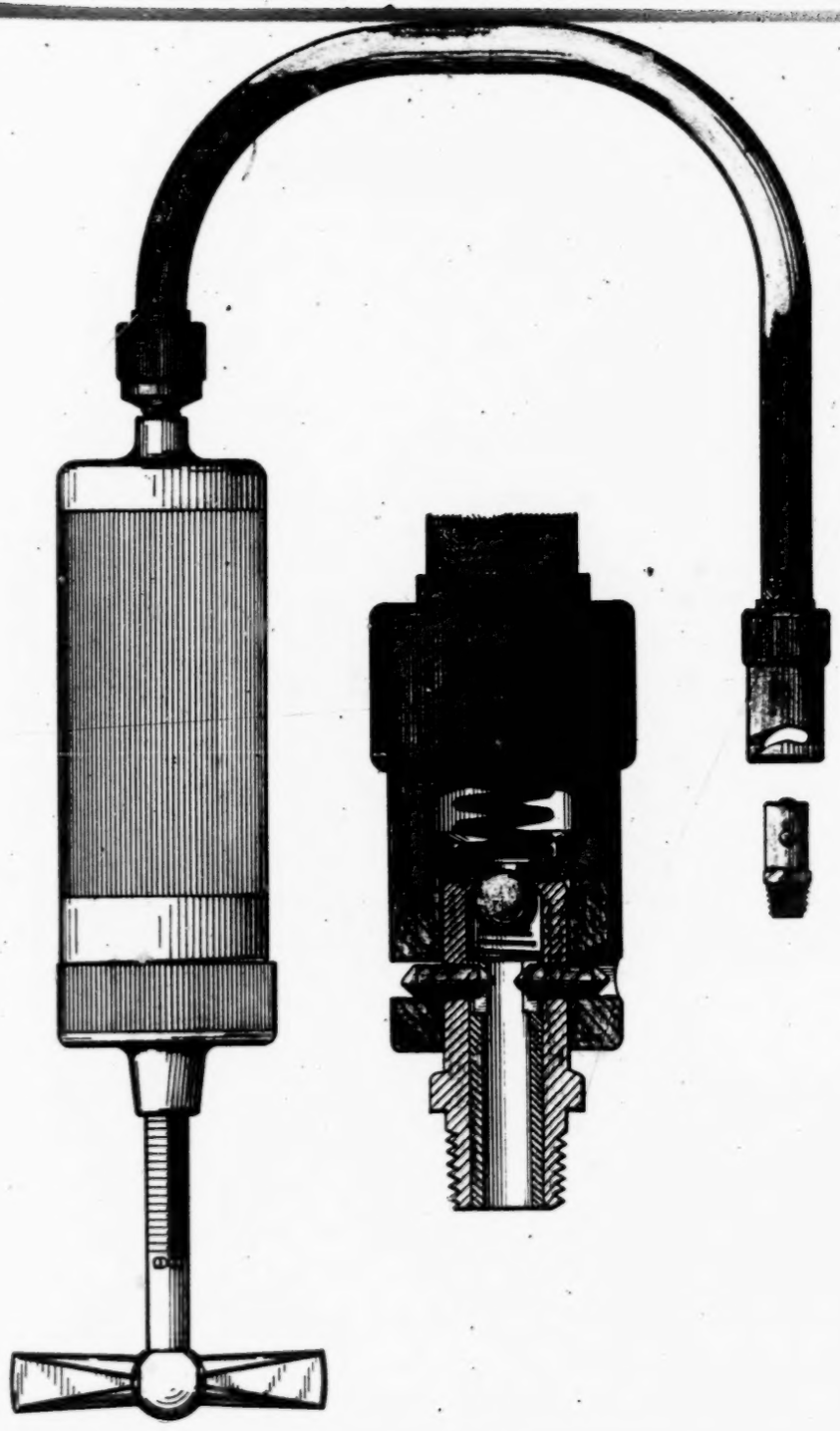
COPY OF PLAINTIFF'S EXHIBIT 45.

Drawing of Respondent's Compressor and Coupler Outfit of Plaintiff's Exhibit 5 Shown in Conjunction With Petitioners' Fitting of Plaintiff's Exhibit 17.

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COPY OF PLAINTIFF'S EXHIBIT 45.

Drawing of Respondent's Compressor and Coupler Outfit of Plaintiff's Exhibit 5 Shown in Conjunction With Petitioners' Fitting of Plaintiff's Exhibit 17.

CLAIM 3.

The combination with a hollow coupling member having a spring-pressed closure,

of a pump,

a discharge conduit having one end secured to the outlet of said pump,

a second hollow coupling member for receiving the closed end of said first named coupling member secured to the other end of said conduit,

a perforated sealing disk mounted to reciprocate in the bore of said coupling member,

means for yieldingly urging said sealing disk against the closed end of said first named coupling member,

and means for limiting the movement of said sealing disk toward said second coupling member.

CLAIM 4.

The combination with a hollow coupling member having a spring-pressed closure,

of a pump,

a discharge conduit having one end secured to the outlet of said pump,

a second hollow coupling member for receiving the closed end of said first named coupling member secured to the other end of said conduit,

a perforated sealing disk mounted to reciprocate in the bore of said coupling member,

and means for yieldingly urging said sealing disk against the closed end of said first named coupling member.

CLAIM 8.

The combination with an apparatus having a part [the bearing (not shown)] to be lubricated, of a conduit for conducting lubricant to said part,

a coupling member secured to the end of said conduit and provided with a spring-pressed valve closure,

means for supplying lubricant to said conduit comprising a receptacle,

provided with a discharge outlet,

a second coupling member connected with said discharge outlet, means for detachably uniting said coupling members,

and means for sealing the joint between said coupling member and for removing excess lubricant from the adjacent ends thereof when said coupling members are uncoupled.

Gullborg Patent 1,307,734.

CLAIM 14.

The combination with a grease cup comprising a tubular member having one end flanged inwardly to provide a closure seat,

a closure,

a pin extending through said tubular member and from both sides thereof,

and a spring confined between said pin and closure, and tending to hold said closure on its seat,

of a grease pump having a discharge conduit,

and means co-acting with the ends of said pin for detachably connecting the discharge end of said conduit with said grease pump. (cup)

CLAIM 15.

The combination with a grease cup comprising a tubular member having a closure seat,

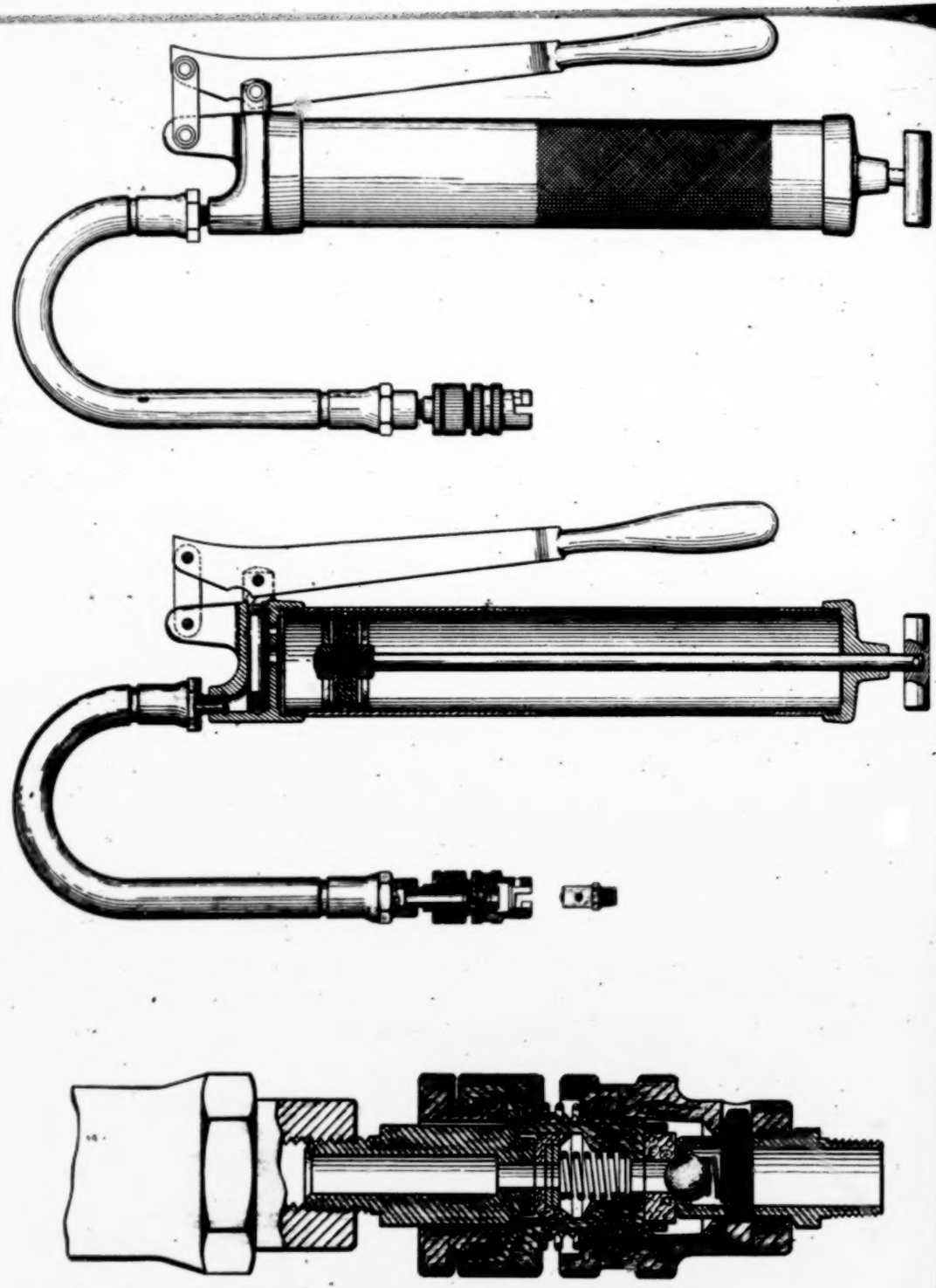
a closure,

a pin extending through said tubular member and from both sides thereof,

and a spring confined between said pin and closure, and tending to hold said closure on its seat,

of a grease pump having a discharge conduit,

and means co-acting with the ends of said pin for detachably connecting the discharge end of said conduit with said grease cup.



COPY OF PLAINTIFF'S EXHIBIT 36.

Drawing of Petitioners' Compressor and Coupler Outfit of Plaintiff's Exhibit 16 Shown in Conjunction with Respondent's Alemite Pin Fitting of Plaintiff's Exhibit 4.

As Plaintiff's Exhibit 36 (R., p. 155) there is in evidence a drawing of defendant-petitioners' compressor and coupler outfit of Plaintiff's Exhibit 16, shown in conjunction with an Alemite pin fitting of the type submitted as Plaintiff's Exhibit 4. As Plaintiff's Exhibit 45 (R., p. 269) there is in evidence a drawing of respondent's Alemite compressor and coupler outfit, of Plaintiff's Exhibit 5, shown in conjunction with defendant-petitioners' fitting of the type submitted as Plaintiff's Exhibit 17. Regardless of the size or form of respondent's compressor outfits, they terminate in an Alemite coupler of the form shown in the drawing, Plaintiff's Exhibit 45 (R., p. 269).

On the accompanying sheet containing a copy of the drawing of Plaintiff's Exhibit 45, we have copied claims 1, 2, 3, 4 and 8 of the Gullborg patent. The drawing has been colored and the corresponding elements in the claims have been underscored in the same colors.

On the accompanying sheet we have reproduced Plaintiff's Exhibit 36, a drawing of defendant-petitioners' compressor and coupler outfit of Plaintiff's Exhibit 16, which is shown in conjunction with an Alemite pin fitting, a specimen of which is in evidence as Plaintiff's Exhibit 4. In one figure the coupler and fitting are shown enlarged. The sheet also contains claims 14 and 15 of the Gullborg patent. The drawing has been colored and the corresponding elements in the claims have been underscored in the same colors, to facilitate the court's application of the claims to the combination.

In view of some of the arguments which have been addressed to the Court, it is perhaps worthy of particular note that:

(1) Claims 14 and 15, based as they were upon Gullborg's earlier invention as disclosed in his application filed on February 11, 1918, read clearly, smoothly, and exactly upon the disclosure of that earlier application as shown in its drawings and specification (*i. e.*, the drawings and specification of patent No. 1,307,733, R., pp. 212-214).

(2) These claims 14 and 15 read clearly, smoothly, and exactly upon the defendant-petitioners' compressor when combined with the plaintiff-respondent's fittings as shown in Plaintiff's Exhibit 36 (reproduced in our second insert).

(3) Claims 1, 2, 3, 4 and 8 cannot be read at all upon the disclosure of Gullborg's earlier application of February 11, 1918, as shown in his drawings and specifications of that date and as contained in his issued patent No. 1,307,733, for the reason that the sliding sealing disk and its associated spring had not even been thought of, and are therefore absent in the drawings and specifications as filed on February 11, 1918.

(4) These claims 1, 2, 3, 4 and 8 do read clearly, smoothly, and exactly upon the defendant-petitioners' fittings when combined with the plaintiff-respondent's compressor as shown in Plaintiff's Exhibit 45 (reproduced in the first of our inserts).

At the outset of the trial, and throughout the consideration of this case in the District Court and in the Court of Appeals, all of these claims 1, 2, 3, 4, 8, 14 and 15, were conceded to be valid (R., pp. 98, 127).

Although the petitioners have attempted now to withdraw their concession of validity, and have urged this Court to hold all of these claims invalid, it is not even now urged on behalf of the petitioners that these

claims do not clearly, smoothly, and exactly describe the combinations which the ultimate users make up, precisely as shown in the exhibit drawings reproduced in our two inserts.

Even now, in this Court, it is conceded by the petitioners that if the claims of the Gullborg patent in suit are to be read and applied just as they appear in the patent in suit, and just as they must be interpreted in the light of the devices which they were drawn to describe, they apply perfectly in every respect to the lubricating equipments into which the petitioners expected their customers to incorporate the parts sold by them. It is conceded that if these claims are to be read as they were written and as they apply to the disclosures of the applications in which they were originally made and finally allowed then the petitioners have contributorily infringed them.

No Court Is Warranted in Rewriting a Patentee's Combination Claims to Incorporate Additional Elements Which the Patentee Chose Not to Include.

We have seen that claims 1, 2, 3, 4 and 8 of Gullborg's patent do not include as elements of the recited combinations, the various details of the pin fitting part as narrowly set forth in claims 14 and 15, *e. g.*, "a tubular member having one end flanged inwardly to provide a closure seat, a closure, a pin extending through said tubular member and from both sides thereof, and a spring confined between said pin and closure and tending to hold said closure on its seat."

We have seen that the combinations of claims 14 and 15 do not include the "suction effect" details of claims 1, 2, 3, 4 and 8, *e. g.*, "a perforated sealing disk

slidably mounted in the enlarged portion of said bore, and a spring confined between the ends of said conduit and said disk for urging said disk against said first-named coupling member."

Yet, counsel for petitioners proclaims boldly that unless the Court is willing, in spite of the defendant-petitioners' formal and continued concession of its validity, to hold the plaintiff's patent invalid, then it is the duty of the Court completely to rewrite Gullborg's patent by incorporating into claims 1, 2, 3, 4 and 8 all of the pin fitting elements found in claims 14 and 15, and to rewrite claims 14 and 15 by incorporating into them all of the suction effect coupler elements found in claims 1, 2, 3, 4 and 8. As counsel put it, this must be done

> "by construing the pin-fitting claims as though also limited to the specific suction-effect grease-gun disclosed in the patent, and by construing the suction-effect claims as also limited to the specific pin-fitting disclosed in the patent, as in *Alemite* v. *Lubrair*, 62 Fed. (2d) 899 (C. C. A. 1) and *Hollingshead* v. *Bassick*, 73 Fed. (2d) 543 (C. C. A. 6)." (Petitioners' Brief, p. 54.)

In other words, all of the claims must be rewritten so as to make them all just alike.

This astonishing proposal and procedure fly directly in the face of a long line of judicial authority and precedent.

It is well settled that limitations or elements contained in one claim of a patent are not to be read into another claim from which they are absent so as to make the two coextensive. This rule was recognized by the Supreme Court in *Symington Co.* v. *National Malleable Castings Co.*, 250 U. S. 383, wherein it said through Mr. Justice Van Devanter, at page 385:

"One of the elements called for by the claims in the Byers patent which were sustained is a 'pocket' or housing, which is to hold other parts in place. The corresponding element of the Emerick patent is described as 'counterpart castings,' and is in two parts. Whether the Byers pocket was to be integral or might be in two or more parts is a matter about which the two courts differed. In the Maine suit it was held that the claims were not limited to an integral pocket, but in the Illinois suit the ruling was the other way. The former view, as it seems to us, is the right one. **There is nothing in Byers' claims which were sustained, indicating that the pocket is to be integral, while there is a distinct call for such a pocket in claim nine. The difference in terms points persuasively to a difference in purpose, and the specification does even more, for it says, 'The pocket may be cast in a single piece.' This is the common form of designating an admissible alternative in such instrument.**"

This doctrine, that different claims of a patent may not be rendered coextensive or as limited to the same elements by the indiscriminate transposition of elements from one claim in which they appear to another from which they have been expressly omitted, has been uniformly adhered to by the several Circuit Courts of Appeals.

In the case of *Skelton* v. *Baldwin Tool Works*, 58 Fed. (2d) 221, the Fourth Circuit Court of Appeals, at page 227, expresses the rule as follows:

"The claims in suit do not expressly limit the structure to a unitary form; and the limitation in other claims may not be used to restrict those upon which the plaintiffs rely. *Symington Co.* v. *National Mal. Casting Co.*, 250 U. S. 383, 39 S. Ct. 542, 63 L. Ed. 1045; *Pangborn* v. *Sly Mfg. Co.*, (C. C. A.), 284 F. 217."

In the case of *Parsons* v. *Seelye,* 100 Fed. 455, the First Circuit Court of Appeals said, at page 457:

> "The court below took the view that it could not disregard what the patentee terms one of the most important features of his invention, that of counterweighting the beam, E; and upon this view the counterweighting was there treated as a necessary and important feature of the mechanism described in claims 3, 4, and 5, and, as the defendant's machine did not employ the counterweighting feature, that infringement did not exist. We cannot take this view, for the reason that the counterweighting feature is not stated as an element of either claims 3, 4, or 5, and it is not essential to the effective operation of the mechanism described in [illegible]aims. The feature of counterweights, therefore, is quite foreign to the combination of elements involved in the intermitting and driving mechanism expressly described in these claims. It is true that counterweights are included in claims 1, 2, 6, and 7, as a specific element of the combination there described; but these claims are abandoned, so far as this case is concerned, for that reason. But the idea that the inventor deemed counterweights essential, under claims 3, 4, and 5, where they are not named as an element, is not expressed, and it is not easy to assume that they were a necessary element of the combination described in such claims. Moreover, while they are described as an important feature, the general expression describing such feature is limited by what follows, wherein he describes their function as relating to the balance and cross balance in heavy machines. It is quite possible that Parsons over-estimated the importance of this feature in this respect; but, under the circumstances, we do not think this general remark, afterwards materially qualified, and limited to the function of maintaining balance and cross balance in heavy machines, should be read into claims 3,

> 4, and 5, where it does not exist, where it was not expressed, and where it is not essential, as all concede, for the purpose of operating that which is quite complete without it."

The First Circuit Court of Appeals stated this doctrine very concisely in *Bresnahan et al.* v. *Tripp*, 102 Fed. 899, 900:

> "The contention is also opposed to the general rule of construction, applicable where there are several claims, to the effect that, if some of the claims are limited to details those which remain are *prima facie* not to be fettered by insisting that they contain, as necessary elements, the particulars which are specifically covered elsewhere."

See also to the same effect, the opinion of Judge Woods for the Fourth Circuit Court of Appeals in the case of *Pangborn Corporation* v. *Sly Mfg. Co.*, 284 Fed. 217, and the extended discussion of the principles of claim construction by Judge Denison, speaking for the Sixth Circuit Court of Appeals in the case of *Wm. B. Scaife & Sons Co.* v. *Falls City Woolen Mills*, 209 Fed. 210.

1. PETITIONERS' THEORY OF "NON-INFRINGEMENT," IF SUSTAINED, WOULD LIMIT EVERY PATENT TO PRECISELY THAT WHICH IS ILLUSTRATED, AND THAT ALONE.

The petitioners' new and astonishing and previously unconsidered theory of "non-infringement" is based solely upon the contention that Section 4888 of the Revised Statutes (U. S. Code, Title 35, Section 33), (in requiring that the inventor, after describing in the specification and portraying in the drawings his alleged invention or discovery, shall "particularly point

out and distinctly claim" his invention), means that the patent claim must particularly point out and distinctly claim *all* of the details of the embodiment illustrated and described in the accompanying drawings and specification.

This contention of petitioners is so distinctly contrary to the long established rules of patent law that in our opinion it scarcely needs an answer. If it were sound, no patent would be of the slightest value.

It has always been recognized that the statutes require the inventor merely to disclose the "best"* form known to him for the practice of his invention, and do not require him to describe and portray every possible embodiment. The very purpose of the patent statute in requiring the inventor to "particularly point out and distinctly claim" his invention, is to require the inventor, in his claims, to distinguish the real heart of the invention from the particular form in which the inventor has exemplified it in his drawings and specifications. If the inventor could claim no more than all of the details of the form illustrated, all that would be necessary would be a set of drawings. The claim of a patent, however, under established rules is for the very purpose of defining the breadth of the monopoly to be asserted by the inventor. As stated by Mr. Jus-

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* Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and **the best mode in which he has contemplated applying that principle**, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor. (R. S. Sec. 4888; Mar. 3, 1915, c. 94, Sec. 1, 38 Stat. 958; Title 35, U. S. Code, Section 33).

tice Bradley in *White* v. *Dunbar,* 119 U. S. 47, 52, 30 L. Ed. 303, 304:

> "The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is."

That the patent is not to be limited to all of the details of the embodiment shown in the patent drawings or described as the preferred embodiment in the specification, was long ago settled by this Court.

In the "Corn Planter Patent Cases," *Brown* v. *Guild,* 90 U. S. 181, 221, 23 L. Ed. 160, 169, Mr. Justice Bradley said:

> "By this description, Brown was evidently attempting to show how simply and cheaply the thing could be made, not that it was to be confined to that specific form. It might as well be contended that he intended to confine his invention to wood, and that a machine made of iron or other metal, though made in precisely the same form, would not be an infringement, because it would not have the same quality of cheapness and simplicity which he describes. In fine, we do not understand Brown as limiting his invention to this cheap form, but as showing how cheaply and simply it would bear to be constructed. This, we think, is the fair meaning of his language when taken in connection with the whole specification. A literal construction is not to be adopted where it would be repugnant to the manifest sense and reason of the instrument."

The best and most concise statement of the rule as we understand it to be, and directly contrary to petitioners' present contention, is contained in the opinion of Mr. Justice Stone in the case of *Smith* v. *Snow,* decided by your Honors on January 7, 1935, and reported in 294 U. S. 1; wherein it was stated, at page 11:

"We may take it that, as the statute requires, the specifications just detailed show a way of using the inventor's method, and that he conceived that particular way described was the best one. But he is not confined to that particular mode of use since the claims of the patent, not its specifications, measure the invention. *Paper Bag Patent Case* (*Continental Paper Bag Co.* v. *Eastern Paper Bag Co.*), 210 U. S. 405, 419, 52 L. Ed. 1122, 1128, 28 S. Ct. 748; *McCarty* v. *Lehigh Valley R. Co.*, 160 U. S. 110, 116, 40 L. Ed. 358, 361, 16 S. Ct. 240; *Winans* v. *Denmead*, 15 How. 330, 343, 14 L. Ed. 717, 722. While the claims of a patent may incorporate the specifications or drawings by reference, see *Snow* v. *Lake Shore & M. S. R. Co.*, 121 U. S. 617, 630, 30 L. Ed. 1004, 1008, 7 S. Ct. 1343, and thus limit the patent to the form described in the specifications, it is not necessary to embrace in the claims or describe in the specifications all possible forms in which the claimed principle may be reduced to practice. It is enough that the principle claimed is exemplified by a written description of it and of the manner of using it 'in such full, clear, concise, and exact terms' as will enable one 'skilled in the art to make, construct, compound and use the same.' "

2. THERE IS NO WARRANT FOR THE APPLICATION OF THE PETITIONERS' NEW THEORY THAT THE COURT SHOULD RELIEVE THE DEFENDANT-PETITIONERS OF LIABILITY FOR INFRINGEMENT "BY GIVING THE GENERIC REFERENCE TO THE OLD DEVICES IN THE CLAIMS SUCH A LIMITED INTERPRETATION AS WOULD EXCLUDE FROM THEIR SCOPE THE DEFENDANTS' ADMITTEDLY OLD (*sic*) DEVICES." (Petitioners' Brief, p. 46.)

At 168 places in his brief, counsel for the petitioners refers to the "old" or the "admitted" or the "admittedly old" this, that or the other. Not once, how-

ever, does he cite or point to the record or to any other evidence showing when or where or how these devastating "admissions" were made. The simple and complete answer to counsel's assertions is our denial of having admitted any of the things attributed to us.

As to the 134 assertions in counsel's brief that this, that or the other thing was "old," it is to be observed that the only citations of the record in this regard are made by counsel for the petitioners on page 21 of his brief. At that place he refers to "Plaintiff-Respondent's *earlier* Gullborg patent No. 1,307,733 not in suit (R., pp. 212-14)." Gullborg patent No. 1,307,733 is not in any substantive sense "earlier" than Gullborg patent No. 1,307,734.

Both of these patents issued on the same day.

PETITIONERS' ASSERTION THAT GULLBORG PATENT IN SUIT NO. 1,307,734 MUST BE NARROWLY INTERPRETED (OR HELD INVALID!) IN VIEW OF THE ISSUE OF ANOTHER PATENT NO. 1,307,733 TO THE SAME GULLBORG ON THE SAME DAY, IS UTTERLY UNWARRANTED.

The only "prior art" in the record to which petitioners refer or could refer in support of their assertions as to what was old and as to what was "admittedly old," is Gullborg patent No. 1,307,733 (R., pp. 212-214).

We are not misunderstanding,—we are not misstating the basis for petitioners' assertions; for, on page 21 of petitioners' brief, they say:

> "In the case at bar, the combination of a grease pump, of a hose, of a hose-coupler, and of a grease-cup (to be temporarily engaged by the latter), was admittedly old prior to the filing of the application for the patent here in suit . . . as

> disclosed in plaintiff-respondent's earlier Gullborg patent No. 1,307,733 not in suit (R., pp. 212-14)."

Section 4886 of the Revised Statutes (Title 35, Section 31 of the United States Code)* specifies the requirements for the patentability of an invention. A very simple consideration of the requirements of the statute shows that Gullborg's patent No. 1,307,733 has no bearing whatsoever upon the validity or scope of Gullborg's patent No. 1,307,734. Thus:

> "not known or used by *others* in this country."

What was known by Gullborg was not something known by "others",

> "before his invention or discovery thereof."

Gullborg may have made the invention claimed in patent No. 1,307,734 after he filed his application for patent No. 1,307,733, or at the time he filed his application for patent No. 1,307,733, or before he filed his application for patent No. 1,307,733, but Gullborg could not have known of his own invention before he made his invention or discovery. His invention and his knowledge were necessarily simultaneous.

> "not patented or described in any printed publication in this or any foreign country before his invention or discovery thereof."

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* Section 4886, R. S. U. S., Title 35, Section 31, U. S. Code, reads as follows:

> "Inventions patentable. Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon the payment of the fees required by law, and other due proceeding had, obtain a patent therefor. (R. S. Sec. 4886; Mar. 3, 1897, c. 391, Sec. 1, 29 Stat. 692.)"

Even if the invention claimed in patent No. 1,307,734 were fully disclosed in Gullborg's patent No. 1,307,733, or in his application of February 11, 1918, for that patent, it would not, by virtue of Gullborg's patent No. 1,307,733, have been patented or described before Gullborg's invention or discovery of the subject-matter therein patented or described.

> "not patented or described in any printed publication in this or any foreign country . . . more than two years prior to his application."

Gullborg's patent No. 1,307,733 was issued on June 24, 1919, the same day as his patent No. 1,307,734, and not, therefore, "more than two years prior to" Gullborg's application of December 21, 1918.

That where two patents issue on the same day there is no presumption that either issued prior to the other, no matter which bears the higher patent number, is well settled. As to this rule there never has been and could not be any question. Both patents issuing on the same day, expire on the same day. That one bears a higher number than the other is no indication that the patents were even signed and sealed in this order.

Even if Gullborg's two patents had not issued on the same day,—even if they had issued years apart, the law is well settled that if the two applications were copending in the Patent Office, then the patentee's prior patent is not "prior art" as against a subsequent patent to the same inventor. There is no conflict between the authorities as to this matter. At one time the Second Circuit Court of Appeals held a view which diverged somewhat from that universally held by the other circuits, but in the Sixth Circuit Court of Appeals' decision in *Southern Textile Machinery Co.* v. *United Hosiery Mills Corp.*, 33 Fed. (2d) 862, reference was made to

the more recent view of the Second Circuit Court of Appeals as expressed, for example, in the opinions in *Traitel Marble Co.* v. *U. T. Hungerford Brass & Copper Co.*, 22 Fed. (2d) 259, in *Gibbs* v. *Triumph Trap Co.*, 26 Fed. (2d) 312, and in *Claude Neon Lights, Inc.* v. *Machlett & Sons*, 27 Fed. (2d) 702.

Since those decisions by the Second Circuit Court of Appeals, all of the circuits have been in agreement upon this rule. To illustrate this rule we quote briefly from the decisions of the Sixth Circuit Court of Appeals in *Sandy MacGregor Co. et al.* v. *Vaco Grip Co.*, 2 Fed. (2d) 655, and *Southern Textile Machinery Co.* v. *United Hosiery Mills Corp.*, 33 Fed. (2d) 862, and from the decision of the Second Circuit Court of Appeals in *Traitel Marble Co.* v. *U. T. Hungerford Brass & Copper Co.*, 22 Fed. (2d) 259.

Sandy MacGregor Co. et al. v. *Vaco Grip Co.*, 2 Fed. (2d) 655, 656 (C. C. A. 6, December 11, 1924—Denison, Circuit Judge):

> "The second patent is attacked because the details therein claimed are said not to show any invention as compared with the disclosure of the earlier numbered patent; and this earlier numbered patent is said to be, with reference to the other, a part of the prior art.
>
> "We can see no basis for this latter proposition. It loses sight of the fact that the question of prior art comes into the patent law through the statutory provision that a patent shall be invalid if the patentee was not the first inventor. The whole question obviously must have reference, not to the date of the patent, but to the date of the patentee's invention.
>
> "Nor do we understand how, save for some arbitrary purpose and by arbitrary rule, there can be any priority of grant or of publication as between two patents issued to the same patentee on the

same day. Courts ordinarily decline to recognize fractions of a day; but to find this priority between simultaneous patents bearing successive numbers distinctions of time would come down to a matter of seconds. The issue clerk might and probably would recognize the request of the patentee as to priority in number between two patents on the same day; but, lacking such request and compliance, the result would depend upon which one the clerk happened to pick first out of the several hundred issuing on that day.

"It seems to us to be beyond dispute, upon the principles involved, that, if the combination *a b c* when first made by the patentee was invention, and if the addition of the element *d* adds utility, even though of itself it would not involve invention if compared with the earlier invention of *a b c* by some one else, yet the patentee is entitled to claims upon *a b c* and upon *a b c d*, and the validity of the second claim may rest, in part, upon its inclusion of the invention more broadly stated in *a b c*. Most naturally these claims would appear as generic and specific in the same patent; but, if the rules of the Patent Office require, or if the patentee desires and the rules of the Patent Office permit, the issue of separate patents to the same inventor, and they are issued the same day, it cannot be said that the one which bears the earlier application date or issue number is part of the prior art as against the other one—always assuming that 'prior art' is a matter not touching dedication or double patenting. This was the conclusion we reached upon a discussion of the authorities in *Higgin Co.* v. *Watson*, 263 F. 378, 385, and even in a case where the patents were not simultaneous. The order of their issue was not important in that case save as to the question of double patenting. In the present case the patentee, Smith, at the date of filing his second application, might have canceled the first one and filed an application showing both the original and improved forms of his device, and containing most,

if not all, of the claims here in suit. That he did not do so but kept his improvement patent separate, at the same time avoiding any question of dedication or double patenting, ought not to deprive him of the benefit of otherwise valid claims."

Southern Textile Machinery Co. v. *United Hosiery Mills Corporation* (C. C. A. 6, June 2, 1929), 33 Fed. (2d) 862. (Hickenlooper, Circuit Judge):

"The bill of infringement of complainant's patent, No. 1,050,433, issued January 14, 1913, upon application of Edwin O. Davis, for a machine for uniting knit fabrics, commonly called a looping machine, was dismissed in the district court on the ground that the invention which was the subject of claim 13 in suit was fully disclosed in a patent, No. 1,030,432, issued to the same patentee on the same date, January 14, 1913, but bearing an earlier filing date.

"On February 22, 1909, Davis filed his original application which disclosed the invention in suit and claimed it both in the language of the claim in suit and in more comprehensive claims. Having some difficulties in securing allowance of the broader claims, Davis filed a second application May 14, 1910, likewise disclosing the invention, containing the claim in suit, which had been transferred from the first to the second application, and also containing the broader claims. On June 2, 1910, the claims of the present invention were withdrawn from the earlier application. Both patents issued January 14, 1913. The applications were thus copending, and the effect of the procedure taken in the Patent Office was that of a division. It is now practically conceded by the defendant that the mere fact that the invention was disclosed in the earlier application, from which claims therefor were canceled during copendency of the second application, will not of itself invalidate the patent issued upon the second application containing the claims canceled from the first. This

is quite in accord with the almost uniform adjudication in this and other circuits. *Toledo Plate & Window Glass Co.* v. *Kawneer Mfg. Co.*, 237 F. 364, 367 (C. C. A. 6); *Higgin Mfg. Co.* v. *Watson*, 263 F. 378, 385 (C. C. A. 6); *Traitel Marble Co.* v. *Hungerford Brass & Copper Co.*, 22 F. (2d) 258 (C. C. A. 2); *Ide* v. *Trorlicht, etc. Carpet Co.*, 115 F. 137, 145 (C. C. A. 8); *Montgomery Ward & Co.* v. *Gibbs*, 27 F. (2d) 466 (C. C. A. 4). The apparently conflicting decision in *National Electric Ticket Register Co.* v. *Automatic Ticket Register Corp.*, 15 F. (2d) 257 (C. C. A. 2) is in substance repudiated by the same court in the *Traitel Marble Co. case, supra,* subsequently followed in *Gibbs* v. *Triumph Trap Co.* (C. C. A.), 26 F. (2d) 312, and *Claude Neon Lights, Inc.* v. *Machlett & Son* (C. C. A.), 27 F. (2d) 707."

Traitel Marble Co. v. *U. T. Hungerford Brass & Copper Co.* (C. C. A. 2), 22 Fed. (2d) 259, 260. (L. Hand, Judge):

"Calkins' earlier patent was not part of the prior art, and it is not necessary to the validity of the claims in suit that they should embody a patentable advance over the earlier disclosure. The two applications were copending, and it is a matter of indifference which of the patents issued first, provided that the claims are for separate inventions. This was held after elaborate discussion in *Miller* v. *Eagle Mfg. Co.*, 151 U. S. 186, 14 S. Ct. 310, 38 L. Ed. 121, and had been already decided in *Suffolk Co.* v. *Hayden*, 3 Wa., 315, 18 L. Ed. 76. It has often been decided in this court (*Electrical Accumulator Co.* v. *Brush Electric Co.*, 52 F. 130; *Thomson, etc., Co.* v. *Elmira, etc., Co.*, 71 F. 396; *Kinnear Mfg. Co.* v. *Wilson*, 142 F. 970; *Victor, etc., Co.* v. *American, etc., Co.*, 145 F. 350), and is the law elsewhere (*Thomson, etc., Co.* v. *Ohio Brass Co.*, 80 F. 712 (C. C. A. 6); *Century, etc., Co.* v. *Westinghouse, etc., Co.*, 191 F. 350 (C. C. A. 8).

The issuance of the first patent does not abandon the unclaimed matter in its disclosure, the pendency of the second application rebutting any such inference.

". . . all we have to do in the case at bar is to decide whether the claims in suit are for a separate invention from the original claims allowed upon the first application. Clearly the test of this question is not whether the step between the later claims and the earlier required invention. The whole discussion in the books presupposes that the disclosure would be fatal to the new claims, if it were a part of the prior art, and upon the issue of invention the disclosure, not the claims, is relevant. Where the earlier claims are for one feature of the disclosure and the later for another, no difficulty can arise; but where the earlier claims are generic and the later specific, or vice versa, the matter is not so plain. We shall for argument assume that the original claims of the first patent need not have been strictly limited to the disclosure, and, if so, they covered both continuous and discontinuous lower edges. Nevertheless the continuous edge was not originally shown, and the claims in suit added it as a new feature, designed to effect a result which would not follow upon the practice of the first disclosure, except in case it had been deliberately varied. It is familiar law that a species claim may be a good invention, notwithstanding that the genus is already in the public demesne, which implies that it is a separate invention, and the case at bar is as much an instance of that situation as though the distinction between the old and new claims were patentable. The point was raised and discussed in *Thompson-Houston Co.* v. *Ohio Brass Co., supra,* in a case where the generic patent issued last, a much more serious situation for the patentee."

The rule thus expressed in the Circuits is a mere application of the rule as earlier stated by this Court

in the case of *Suffolk Mfg. Co.* v. *Hayden,* 3 Wall. 315, 18 L. Ed. 76. We quote briefly from this decision, as follows:

> "The suit is brought upon a patent granted to Hayden, the plaintiff below, on the 1st of December, 1857, for an improvement in long trunks for cleaning cotton, ...
>
> "The defendants, in the course of their defense, gave in evidence another patent to the plaintiff, dated 17th March, 1857, for a prior improvement in the long trunk, enlarging one end of the same; and in the specification, a description was given of the improvement patented the December following, and on which the present suit is brought; but in which elder patent the improvement was not claimed; and insisted that the description and the omission to claim in the earlier patent, operated as an abandonment or dedication of it to the public, and that for this reason the subsequent patent of 1st December was void. But the answer to this ground of defense is, that it appeared that Hayden, the patentee, had pending before the commissioner of patents an application for this same improvement at the time he described it in the specification of the 17th March, which was, doubtless, the reason for not claiming it in this patent. The description in no sense affected this application thus pending before the commissioner; and, while it remained before him, repelled any inference of abandonment or dedication from the omission to again claim it."

The reason for the rule thus uniformly expressed by the authorities is, of course, obvious. Since the patent statutes authorize the grant of a patent to the first inventor, that requisite cannot be shown to be non-existent by showing that the same inventor was himself prior, and of course there can be no abandonment or dedication of an invention to the public in the face of an express claim for a patent thereon.

Since Gullborg's patent No. 1,307,733 is the only "prior art" in the record which by any possibility could support the assertions of counsel for the petitioners as to what was old and as to what was "admittedly old," and since that patent is to the same inventor and issued on the same day as the patent in suit No. 1,307,734, there is no basis, in view of the statute and these well-established rules of law, for petioners' assertions that patent No. 1,307,734 must be narrowly construed (or held invalid) in view of the "prior art".

The only item of "prior art" in the entire record is the French Seng patent No. 468,869, which is printed on pages 272-275 of the record. It does not disclose the things asserted by counsel to be "old" and "admittedly old". The defendant-petitioners have not regarded it as of sufficient importance even to warrant its translation into English.

Counsel for the petitioners apparently realizes that the Seng patent does not provide any warrant for his assertions, and that Gullborg's patent No. 1,307,733 is not really available as "prior art" against Gullborg himself. It is for these reasons, doubtless, that counsel endeavors to support his assertions by reference to "the British Alley patent No. 21,893 of 1906, and plaintiff-respondent's own still-earlier Winkley patent No. Re. 14667, cited by the Court of Appeals for the Sixth Circuit in the case of *Lyman* v. *Bassick*, 18 Fed. (2d) 29,—adjudicating the Gullborg patent here in suit."*

*In and by the very opinion to which counsel for the petitioners refers in an effort to supplement the record in this case by matter which was never available for testimony, discussion, argument, or decision herein, the Sixth Circuit Court of Appeals held all of the claims in suit, Nos. 1, 2, 3, 4, 8, 14 and 15, to be valid and to have been contributorily infringed by the sale of non-suction effect compressors, and by the sale of crosspinless fittings identical in every legal aspect with the defendant's devices in the present suit!

It would be manifestly unfair to the plaintiff to have the Court go outside the record in this case and to base its decision upon what meager reference may be found to these alleged prior patents in the opinions of other courts in other cases. The patents do not show or describe the things which counsel assert to be "old" and "admittedly old." We suspect that this Court will not be inclined to guess what these other patents may disclose from what other courts in other cases may have said relative to them.

Nothing in the prior art discloses any such compressors or couplers or fittings as those sold by the petitioners for intended use in the combinations of the patent in suit. Nothing in the prior art requires or warrants a narrowed "interpretation" of the claims of the patent in suit.

No "File-Wrapper" Estoppels Exist or Are Even Alleged to Exist.

Sometimes the range of equivalents accorded to the elements of a patent claim is restricted by cancellations and amendments made in the Patent Office to overcome rejections on one score or another. In the present case the file-wrappers and contents of the Gullborg patents were not offered in evidence by the defendants. They were offered by the plaintiff to show the origin and meaning of claims 14 and 15 of patent No. 1,307,734. While these file-wrappers are therefore available to counsel for the petitioners, there is no contention,—not the slightest suggestion, that these "file-wrappers" afford any basis of estoppel or otherwise upon which to urge a narrow range of equivalents for any of the elements enumerated in any of the claims.

3. The Defendant-Petitioners' Third Theory of "Non-Infringement" Is Wholly New in This Court. It Is Non-Existent in the Law of Patents. It Is Not Found In Or Supported By the Cited Authorities. It Is Repugnant to Established Law, and Incapable of Application.

This third newly concocted theory of non-infringement was not pleaded, presented, argued or considered in the lower courts. It is here advanced for the first time. As stated by counsel for the petitioners, the theory is that a finding of the defendant-petitioners' non-infringement might be reached

> "by holding that the so-called 'combination' claims would not be infringed by the defendant's sale of any old devices which may be included in the claims generically, but will be held infringed only if the defendant appropriates *the* inventive part of the claims or the **gist** of the claims as in the cases of *Harvey Hubbell* v. *General Electric,* 267 Fed. 564 (C. C. A. 2); *Morgan Envelope Co.* v. *Albany Paper Co.,* 152 U. S. 425; 38 L. Ed. 500; *Carbice Corporation* v. *American Patents Development Corp.,* 283 U. S. 27; 51 Sup. Ct. 334." (Petitioners' Brief, p. 47.)

(The bold face emphasis upon the word "gist" is that of petitioners' counsel.)

"The **gist** of the claims"!

What is the **"gist"** of a claim to a combination?

With the exception of methods and processes, almost every invention is a combination of old elements. The first airplane was a combination of an old engine, an old propeller, old kites and old rudders. The first radio broadcasting equipment was a combination of old wire, old tubes, old filaments, old telephones. It is difficult to think of any invention which by analy-

sis cannot be resolved into a combination of elements, each of which was, in and of itself, old and well known.

We have heretofore alluded to the cases of *Leeds & Catlin* v. *Victor,* 213 U. S. 301, and 213 U. S. 325, which involved the Berliner patent covering the Victor Company's phonograph. It was this case of *Leeds & Catlin* v. *Victor* which the Sixth Circuit Court of Appeals referred to in its decision in *Lyman* v. *Bassick and Six Other Cases,* 18 Fed. (2d) 29, 38, involving this same Gullborg patent No. 1,307,734, as "on all fours" with the present case.

It was indeed in connection with its discussion of questions of contributory infringement identical in every respect with the questions involved in the present suit that in *Leeds & Catlin* v. *Victor* this Court made its famous statement of the attributes of a combination claim. In its opinion in this controllingly parallel case, this Court said:

> "A combination is a composition of elements, some of which may be old and others new **or all old** or all new. It is, however, the combination that is the invention, and is as much a unit in contemplation of law as a single or non-composite instrument. Whoever uses it without permission is an infringer of it. Whoever contributes to such use is an infringer of it. It may be well here to get rid of a misleading consideration. It can make no difference as to the infringement or non-infringement of a combination that one of its elements or all of its elements are unpatented."

Given an invention comprising a combination of elements which are "all old";—Who is to decide which element constitutes the "gist" of the invention? How is he to decide which element constitutes the "gist"?

There is no "gist." The invention inheres in the combination. It is the **entire** combination which "is as

much a unit in contemplation of law as a single or non-composite instrument." The very definition of a combination patent claim precludes the possibility of selecting any one element or any sub-group of elements as constituting the "gist" of the invention. It is only by flying in the face of this revered authority that counsel for the defendant-petitioners can assert, as he does, that Rogers and Dusenberry had the right to bring about the organization of the Gullborg combination by supplying an element or a group of elements in which the "gist" of the invention did not inhere. Obviously, there could have been no element; obviously, there could have been no sub-group of elements, in which the "gist" of the invention inhered. If, therefore, counsel for the defendant-petitioners is right in his contention that his clients had the right to supply some of the elements, then anybody and everybody else had an equal right to supply some or all of the other elements. When carried to its logical conclusion, this means simply that there can be no such thing as contributory infringement. It means simply that a patentee can have no remedy or relief except against the party who ultimately assembles all of the elements of the complete combination.

In the case of a lubricating system such as that of the Gullborg patent, and in the case of a phonograph such as that of the Berliner patent in *Leeds & Catlin* v. *Victor,* the new theory of counsel for petitioners means that the patentee cannot proceed against anyone short of the ultimate user who brings the compressor into association with the fitting or who brings the disk record into association with the stylus and tone arm. As was said by the Sixth Circuit Court of Appeals in *Thomson-Houston* v. *Ohio Brass,* 80 Fed. 712:

> "From the earliest times, all who take part in a trespass, either by actual participation therein or by aiding and abetting it, have been held to be jointly and severally liable for the injury inflicted. There must be some concert of action between him who does the injury and him who is charged with aiding and abetting before the latter can be held liable. When that is present however, the joint liability of both the principal and the accomplice has been invariably enforced. If this healthful rule is not to apply to trespass upon patent property, then indeed the protection which is promised by the Constitution and laws of the United States to inventors is a poor sham. Many of the most valuable patents are combinations of non-patentable elements, and the only effective mode of preventing infringement is by suits against those who, by furnishing the parts which distinguish the combination, make it possible for others to assemble and use the combination, and who, by advertisement of the sale of such parts and otherwise, intentionally solicit and promote such invasions of the patenteee's rights."

If the respondent were, in accordance with the new theory of counsel for the petitioners, relegated to infringement suits against the ultimate users of lubricating equipment, *e. g.*, the millions of owners of automobiles, the patent in suit would, as a practical matter, be "a poor sham,"—it would be utterly valueless to anyone. The amount which could be recovered from any one automobile owner would not cover the fee of the marshal in making service of a chancery subpoena in instituting a suit.

The "gist" theory of counsel for the petitioners is new not only in this case but is new and unheard of in the whole realm of patent law. In alleged support of his startling new proposition, counsel for the petitioners cites, however, three cases:

1. *Harvey Hubbell, Inc.* v. *General Electric Co.*, 267 Fed. 564.

2. *Morgan Envelope Co.* v. *Albany Perforated Wrapping Paper Co.*, 152 U. S. 425.

3. *Carbice Corporation* v. *American Patents Development Corp.*, 283 U. S. 27.

The *Hubbell* case was a simple case of non-infringement because of the failure of defendant's structure to respond to the claims in suit. The opinion of the Second Circuit Court of Appeals leaves no doubt of this.

The patent in suit was for a two-part attachment plug used to connect the cord of an electric appliance to a light socket. The device consisted of an insulated plug threaded for insertion in a light socket, and containing two contact springs mounted within it and so located that electrical connections could be established by insertion of the two blades of the cap attached to the appliance cord. So much of the structure was old and well-known.

The novelty of the device of the patent in suit lay in the provision of a pair of supplementary springs within the plug to engage notches in the cap blades* and thus

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* This locking engagement is demanded in each of the claims in suit as indicated by the italicized portions of the claims:

"1. A separable attachment plug comprising an insulating body having independent recesses, locking contact springs in said recesses and independent guide holes leading into said recesses, and a cap having contact posts adapted to pass through the guide holes, and *engage the locking contact springs*, the walls of said recesses and guide holes closely surrounding the said contact springs and extending beyond the ends thereof, whereby a connection can be established only upon the passage of the contact posts through the guide holes and into the inner spaces constituting said recesses." (Italics supplied.)

"2. A separable attachment plug comprising a base provided with insulating chambers and insulating passages leading into said chambers, contact plates and locking springs in said chambers, an end block secured to the base and covering the chambers, and a cap provided with contacts and adapted to pass through the insulating passages *and engage the* contact plates and *locking springs* in the insulating chambers." (Italics supplied.)

to lock the parts in contact. The blades of the caps sold by defendant lacked these notches and when used with the plug of the patented combination did not make this locking engagement. Consequently there was no infringement. This is made clear by the Court in these passages in its opinion:

> "There was no novelty *per se* in the use of knife blade contacts. They had been commercially used in the Ft. Wayne-Jenney construction, and known at least since 1886. Nor was there inventive thought in securing a locking, as distinct from a frictional, engagement between contact post and *current carrying* spring. That was old, and is found in the senior patent, if nowhere else. The field of invention left open and occupied by Hubbell was to secure a *notched or recessed blade* (of the cap) by a *supplementary* spring, and this he did. That is the only idea validating the locking spring claims, and defendants do not employ that means." (Italics and parenthetical matter supplied.) (267 Fed. 572.)

> "No Bryant cap carries contacts with *recesses* (or notches) suitable for engagement with the Hubbell locking spring. Therefore such caps could be used so as to provide electrical connection when joined to a Hubbell plug, but the only mechanical connection was frictional. For obvious reasons the sale of caps was smaller than that of plugs or bases, and caps and bases severally are articles of commerce. There is no evidence apart from the filing of these two decoy orders; *and it is found as a fact that Bryant Company has manufactured caps, not with the intent of having them used with Hubbell plugs*, but with the hope that the public would buy the Bryant plug for use with the Bryant cap. When so used a locking contact occurs; that a poor mechanical connection did not prevent electrical use with the Hubbell plug or base, was, however, a matter of indifference to Bryant." (Italics supplied.) (267 Fed. 567.)

The case is not authority for the proposition for which petitioners cite it, but merely for the elementary proposition that there can be no infringement, direct or contributory, where the device sold or used does not respond literally or equivalently to the claims of the patent in suit.

In the case of *Morgan Envelope Co.* v. *Albany Perforated Wrapping Paper Co.*, 152 U. S. 425, the Court held that there was no infringement by the sale of rolls of toilet paper for use in a novel fixture by which the paper was dispensed in strips of convenient length, although the claims of the patent in suit embraced the combination of fixture and paper. The decision of the Court expressly recognized the doctrine of contributory infringement by the sale of one element of a patented combination with intent that it be employed to complete the combination, but denied the application of the principle to a situation where "the element made by the alleged infringer is an article of manufacture perishable in its nature, which it is the object of the mechanism to deliver, and which must be renewed periodically whenever the device is put to use" (152 U. S. 433).

The Court stated the question and its answer in these two passages:

> "The first defense raises the question whether, when a machine is designed to manufacture, distribute, or serve out to users a certain article, the article so dealt with can be said to be a part of the combination of which the machine itself is another part. If this be so, then it would seem to follow that the log which is sawn in the mill; the wheat which is ground by the rollers; the pin which is produced by the patented machine; the paper which is folded and delivered by the printing press, may be claimed as an element of a combination

of which the mechanism doing the work is another element. The motion of the hand necessary to turn the roll and withdraw the paper is analogous to the motive power which operates the machinery in the other instances.

"But without expressing an opinion upon this point, we think the facts of this case fail to sustain the charge of infringement." (152 U. S. 431.)

"The real question in this case is, whether, conceding the combination of the oval roll with the fixture to be a valid combination, the sale of one element of such combination, with the intent that it shall be used with the other element, is an infringement. We are of opinion that it is not. **There are doubtless many cases to the effect that the manufacture and sale of a single element of a combination, with intent that it shall be united to the other elements, and so complete the combination, is an infringement.** *Saxe* v. *Hammond, Holmes,* 456; *Wallace* v. *Holmes,* 9 Blatchford, 65; *Barnes* v. *Straus,* 9 Blatchford, 553; *Schneider* v. *Pountney,* 21 Fed. Rep. 399. **But we think these cases have no application to one where the element made by the alleged infringer is an article of manufacture perishable in its nature, which it is the object of the mechanism to deliver, and which must be renewed periodically, whenever the device is put to use.** Of course, if the product itself is the subject of a valid patent, it would be an infringement of that patent to purchase such product of another than the patentee; but if the product be unpatentable, it is giving to the patentee of the machine the benefit of a patent upon the product, by requiring such product to be bought of him. To repeat an illustration already put: If a log were an element of a patentable mechanism for sawing such log, it would, upon the construction claimed by the plaintiff, require the purchaser of the sawing device to buy his logs of the patentee of the mechanism, or subject him-

> self to a charge of infringement. This exhibits not only the impossiblity of this construction of the patent, but the difficulty of treating the paper as an element of the combination at all. In this view the distinction between repair and reconstruction becomes of no value, since the renewals of the paper is in a proper sense neither the one nor the other." (Italics supplied.) 152 U. S. 433.

In the *Carbice* case, 283 U. S. 27, 33, this Court, answering an effort to distinguish the *Carbice* case from the *Morgan* case, stated that the distinction was "without legal significance." Like the *Morgan* case, the *Carbice* case involved a situation where "the element made by the alleged infringer is an article of manufacture perishable in its nature, which it is the object of the mechanism to deliver (employ), and which must be renewed periodically whenever the device is put to use." (152 U. S. 433.)

In the *Morgan* case this Court specifically held that the familiar doctrine of contributory infringement by the sale of one of the permanent structural elements of a combination was not applicable to such a situation.

In the *Carbice* case this Court reiterated the conclusion reached in the *Morgan* case and the distinction there announced, saying:

> "The case at bar is wholly unlike *Leeds & Catlin* v. *Victor Talking Machine Co.*, 213 U. S. 325, 333, on which plaintiffs rely. That was an ordinary case of contributory infringement. The Victor Company sold machines embodying a patent for a combination. Leeds & Catlin were held to be infringers because the intended incorporation in the Victor machines of the article which they sold, did not constitute a repair of the machine, and hence was not within the license implied on sale. *Heyer* v. *Duplicator Mfg. Co.*, 263 U. S. 100. There was

> no suggestion that the Victor Company, which itself manufactured and sold the patented product, sought 'to derive its profits, not from the invention on which the law gives it a monopoly, but from the unpatented supplies with which it is used.' In the case at bar the plaintiffs neither sell nor license others to sell complete transportation packages. They supply merely one of the several materials entering into the combination; and on that commodity they have not been granted a monopoly. Their attempt to secure one cannot be sanctioned."

It is manifest from this brief review of these cases that none of them sustains the proposition for which it is cited by petitioners. Not one of these cases announces or even suggests a doctrine that there is no infringement where the alleged infringer has "not appropriated the gist or inventive part of the claims."

In the *Hubbell* case it was held that there can be no infringement where the device sold does not respond to the literal demand of the claims sued upon.

In the *Morgan* and *Carbice* cases it was held that a combination claim is not infringed by the sale of an unpatented perishable article of commerce which is dispensed or employed in the patented combination and necessarily consumed and periodically renewed in the use of the invention.

Interestingly enough, the *Morgan* case and the *Carbice* case approve the very precedents upon which the present suit must be decided.

In its opinion in the *Morgan* case this Court refers with approval to the "many cases to the effect that the manufacture and sale of a single element of the combination, with intent that it shall be united to the other elements, and so complete the combination, is an infringement." That is precisely the present case.

In the *Carbice* case, this Court said:

> "The case at bar is wholly unlike *Leeds & Catlin* v. *Victor Talking Machine Co.*, 213 U. S. 325, 333, on which plaintiffs rely. That was an ordinary case of contributory infringement. The Victor Company sold machines embodying a patent for a combination. Leeds & Catlin were held to be infringers because the intended incorporation in the Victor machines of the article which they sold, did not constitute a repair of the machine, and hence was not within the license implied on sale. *Heyer* v. *Duplicator Mfg. Co.*, 263 U. S. 100. There was no suggestion that the Victor Company, which itself manufactured and sold the patented product, sought 'to derive its profits, not from the invention on which the law gives it a monopoly, but from the unpatented supplies with which it is used.'"

It would be impossible to find a case more completely and exactly on all fours with *Leeds & Catlin* v. *Victor* than is the present case of *Rogers and Dusenberry* v. *Alemite*. What this Court said of the *Victor* case can be said of this "Alemite" case:

> "This is an ordinary case of contributory infringement. The Alemite Corporation sold machines embodying a patent for a combination. Rogers and Dusenberry were held to be infringers because the intended incorporation in the Alemite machines of the article which they sold, did not constitute a repair of the machine, and hence was not within the license implied on sale. *Heyer* v. *Duplicator Mfg. Co.*, 263 U. S. 100. There was no suggestion that the Alemite Corporation, which itself manufactured and sold the patented product, sought to 'derive its profits, not from the invention on which the law gives it a monopoly, but from the unpatented supplies with which it is used.'"

If the Alemite Corporation sought to derive its profits from the sale of grease to be used in or as a part of its lubricating equipment, then we should have a situation akin to that in the *Carbice* case. There is not, however, the breadth of a suggestion that the Alemite Corporation has included the grease as an element of its patent claims, or that it has licensed the purchasers of its grease to use the apparatus of the Gullborg patent, or that it has sold or attempted to sell its lubricating apparatus upon the condition that the purchasers buy their supplies of grease from the Alemite Corporation.

IV.

A General Answer to the Petitioners' Generalities.

At one point (pp. 33-34) in his brief counsel for the petitioners abandons all of his particularized theories and contentions, and frankly states the gravamen of his distress. He says:

> "The practical form in which the question is presented in the present case is the situation of a car owner whose car was equipped by its manufacturer with a set of the patented pin-fitting. Whether there was also placed in the tool box of the car at the time it was sold one of the small Alemite hand guns fitted with a coupler for attachment to the pin-fittings is not important because this car owner, in common with most car owners, prefers to have his car greased at public greasing stations where the grease is furnished from large compressors through a conduit which may be coupled to each of the pin-fittings on the car in the course of the greasing operation.
>
> "Now if the decision of the Third Circuit Court of Appeals is to prevail, in the case at bar, the car owner stands in an anomalous position. If the

> unpatented grease-guns (compressors and couplers) with which the greasing stations are equipped happen to be of a manufacturer other than that of the plaintiff (who owns the patent on the combination of the patented pin-fitting with the necessary old pump and coupler), then both the car owner and the service station proprietor will each be infringers of the combination patent and the manufacturer who supplied the greasing station with its compressors and couplers will be a contributor to that infringement; whereas if the greasing station proprietor had purchased his compressors from the plaintiff, then no question of infringement would be involved. In other words, the ordinary car owner is put to the duty of first finding out where the greasing station proprietor has purchased his compressor in order to determine whether he, the car owner, may make the ordinary and only possible use of the pin-fittings on his car.
>
> . . . . . .
>
> "We are aware of no applicable decision of this Court on this precise question of patent law, but believe it to be one that should be decided by this Court."

Gullborg's patent gave to him and his assigns and licensees the exclusive right to organize the necessary elements into the combinations of the claims in suit. The practical situation of the automobile owner, described by counsel for the petitioners, is that he has bought one complete organization of the patent in suit from the plaintiff. He is not, however, satisfied with the use of this one organization. "He prefers," as counsel says, "to have his car greased at public greasing stations." At the public greasing station, the combinations of the claims of the Gullborg patent are reorganized and reassembled. Into the newly organized

combination go the car owner's pin fittings which he has purchased from the Alemite Corporation, and also the compressor and coupler parts in the hands of the proprietor of the greasing station. The compressor and coupler parts which the car owner has purchased from the Alemite Corporation remain unused in the tool kit of the owner's car. When the proprietor of the greasing station brings out his compressor and couples it to the car owner's pin fittings, there is brought into being a new organization of the combinations of the claims of the Gullborg patent. This is a combination or organization separate and distinct from that which has been sold to the car owner. To use the language of the opinion of the Supreme Court in the Leeds & Catlin case, the car owner "increases the repertoire of the purchaser's" machine. He gains the advantage of a second organization of the combinations of the claims in suit. If the greasing proprietor has purchased his compressor and coupler parts from the defendants, then this new organization of the invention of the patent has not been sold to either party by the owner of the Gullborg patent. The Alemite Corporation will not derive its legitimate profit upon this second embodiment of the invention of the patent in suit unless the proprietor of the greasing station has purchased his compressor and coupler parts from the Alemite Corporation.

The perplexity of the car owner and of the proprietor of the greasing station, as depicted by counsel for petitioners, seems to us to be the best possible reason why the unlicensed manufacturer of the compressor and coupler parts of the combination as sold to the greasing station proprietor should be held accountable as a contributory infringer. Counsel for the petitioners says that:

> "If the unpatented grease-guns (compressors and couplers) with which the greasing stations are equipped happen to be of a manufacturer other than that of the plaintiff, . . . then both the car owner and the service station proprietor will each be infringers of the combination patent . . . ; whereas if the greasing station proprietor had purchased his compressors from the plaintiff, then no question of infringement would be involved."

What "a poor sham," indeed, would be the respondent's patent if the Alemite Corporation were relegated to suits against car owners and service station proprietors. If service station proprietors had the right to buy their compressor and coupler parts of the combinations from unlicensed manufacturers, then the Alemite Corporation would be relegated to the enforcement of minor claims against millions of minor infringers. In accordance with the doctrine of contributory infringement, it can maintain its suit against the manufacturer of the compressor and coupler parts, who alone makes possible these millions of minor infringements.

Counsel for petitioners says, in effect, that if the patent rights of the plaintiff are protected, then the "car owner is put to the duty of first finding out where the greasing station proprietor has purchased his compressor in order to determine whether he, the car owner, may make the ordinary and only possible use of the pin fittings on his car." This is quite an unfair and unwarranted presentation of the situation arising under the facts assumed by counsel. Under the "practical situation" assumed by counsel, "there was also placed in the tool box of the car at the time it was sold one of the small Alemite hand guns fitted with a coup-

ler for attachments to the pin fittings." (Petitioners' Brief, p. 33.) The car owner's trip to the greasing station is not "the ordinary and only possible use of the pin fittings on his car." He is quite free, if he chooses, to take out of his tool kit the compressor and coupler which he has purchased from the Alemite Corporation, and to use them in conjunction with the pin fittings on his car. He is quite free, if he chooses, to ask the greasing station proprietor to inject grease into the pin fittings on his car by the use of the Alemite compressor and coupler which the car owner has purchased and put in the tool box of that car. As counsel puts it, however, he "prefers to have his car greased at public greasing stations where the grease is furnished from large compressors through a conduit which may be coupled to each of the pin fittings on the car in the course of the greasing operation." If such is his preference, and if such is the preference of the greasing station proprietor, it is difficult to think of any good reason why the greasing station proprietor should not buy the compressor and coupler parts of the complete combination from the Alemite Corporation, rather than from some unlicensed manufacturer such as Rogers and Dusenberry. In one respect we agree with counsel for the petitioners. We agree with him that "whether there was also placed in the tool box of the car at the time it was sold one of the small Alemite hand guns fitted with the coupler for attachment to the pin fittings is not important." (Petitioner's Brief, p. 33.)

The greasing station proprietor is of course free to buy and have in his possession compressor and coupler parts sold to him by the Alemite Corporation. With these the greasing station proprietor may grease the

car owner's automobile without any question of liability on the part of either. In such a situation, counsel for the petitioners will not have any occasion to weep over the plight of "the ordinary car owner (who) is put to the duty of first finding out where the greasing station proprietor has purchased his compressor."

Counsel for petitioners represents manufacturers of the compressor and coupler parts of the combination. He asserts that they should be free to sell these parts. Precisely the same arguments could be advanced on behalf of someone else who wishes to manufacture and sell the pin fitting parts of the combination. If Rogers and Dusenberry should be free to sell the compressor and coupler parts, then anyone and everyone else should be equally free to sell the pin fitting parts. In such a situation, it would be only the ultimate user who would be accountable to the Alemite Corporation, since it would be only the ultimate user who would assemble the complete combinations of the claims in suit. Obviously, under the contentions of counsel, the plaintiff-respondent's patent would not have the value of the paper upon which it is printed.

V.

Comment Relative to Petitioners' Brief.

Counsel for the petitioners presumes in his brief to tell this Court what the Sixth Circuit Court of Appeals did have before it and did not have before it in the cases decided in the six cases reported at 18 Fed. (2d) 29. The facts presented by counsel are grossly inaccurate and misrepresentative. It seems to us that these representations are peculiarly unwarranted for the reason that upon the trial the plaintiff called El-

wood Hansmann to identify and produce documents and exhibits which would show precisely the facts and structures upon which the decisions of the Sixth Circuit Court of Appeals and other courts were based. The defendants objected to the receipt in evidence of any matter which would state the factual background of these decisions. The objections of counsel for the defendants were sustained. (R., pp. 121 to 126.)

In view of these objections, and in view, therefore, of the absence from the record in this case of the facts of the decisions in other cases, we do not believe that the Court is warranted in accepting counsel's unsupported statements as to what was or what was not the construction of the devices involved in these other suits.

Counsel for the petitioners refers repeatedly to the opinion of the First Circuit Court of Appeals in the case of *Alemite* v. *Lubrair,* 62 Fed. (2d) 899. As is shown in the report of that case at 62 Fed. (2d) 899, the Court disposed of the case without having received any brief on behalf of the appellant, Alemite Corporation, and without having heard any argument on behalf of Alemite. The only appearance of counsel for the Alemite Corporation was upon a motion for a postponement of the argument because counsel for the appellant were actually engaged in the trial of a long lawsuit in the Eastern District of Michigan, between Kellogg Switchboard & Supply Company and American Telephone & Telegraph Company. The consideration of the motion was deferred by the Court until the day previously set for argument, whereupon the motion was denied, and counsel for appellee was at once heard and the brief of counsel for appellee was at once received.